

No. 13,947

IN THE

United States
Court of Appeals

For the Ninth Circuit

THYS COMPANY, a corporation,

Appellant,

vs.

SOPHIE OESTE, an individual,

Appellee.

APPELLEE'S REPLY BRIEF

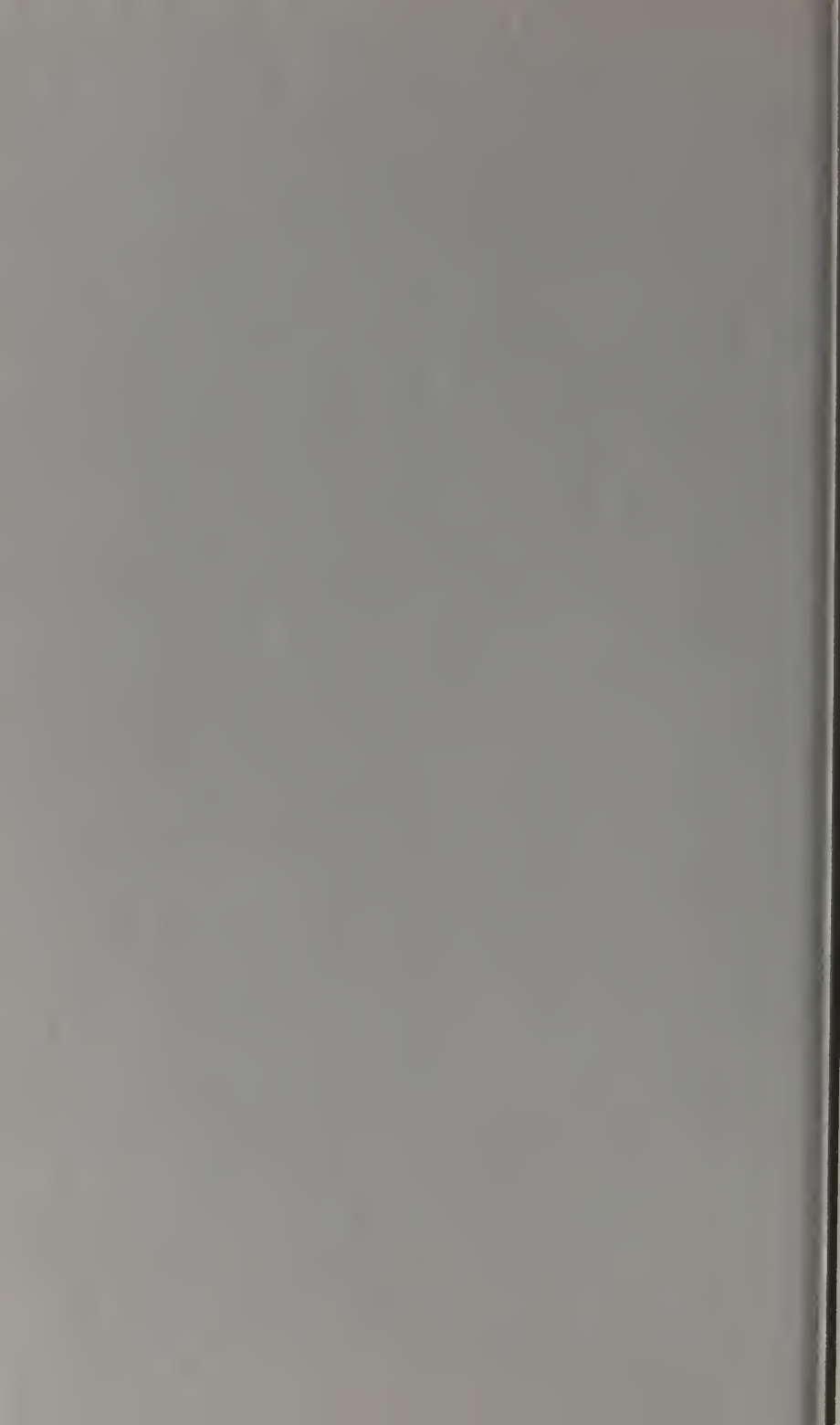
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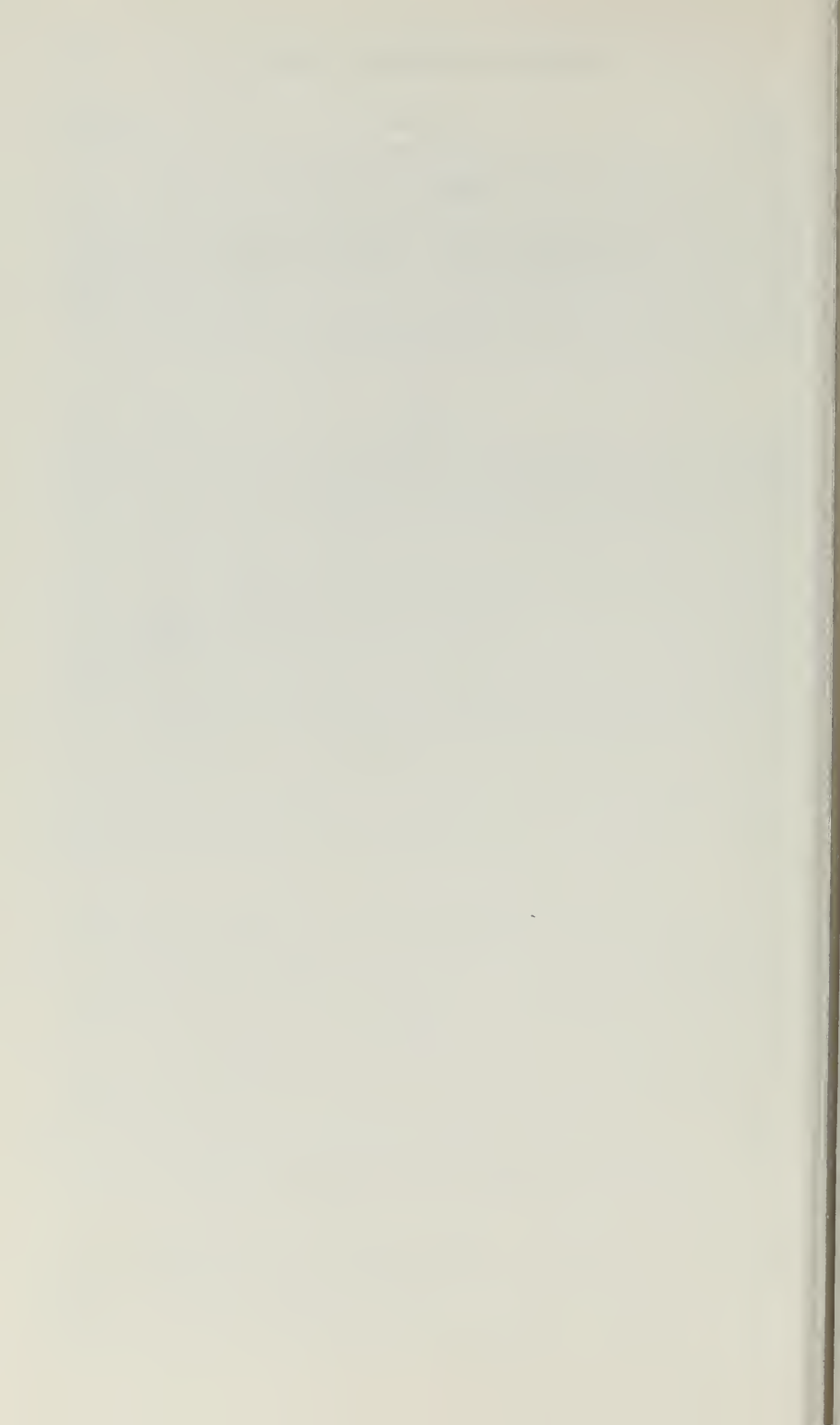
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APPELLEE'S REPLY BRIEF

[References to the record will be found in abbreviated form as (R.) followed by the specific page or pages and the line or lines, whenever line reference is deemed particularly pertinent; references to appellant's Opening Brief will be found in abbreviated form as (Op. Br.) followed by the page or pages.]

PRELIMINARY STATEMENT

The appellee is unable to agree with appellant's statement that the trial court held the Letters Patent involved in this

particular action invalid in toto (although appellee agrees that such should be the case). The appellee is also unable to agree that the appellant's Statement of Points on Appeal (R. 213) presents to this Court for review the issue of infringement of the said Letters Patent (Op. Br. 1). And, the appellee finding the alleged statement of the case by the appellant, commencing on page 3 and concluding on page 20 of its brief, to be in a highly argumentative, rather than a factual form, and further finding that the general presentation (both as to the form and substance) of appellant's entire brief to be confusing, disordered and unintelligible, states as follows:

This appeal is two-fold.

The appellant appeals from a judgment in the United States District Court for the Northern District of California entered June 1, 1953 (R. 40), by the Court sitting without a jury, adjudging claims 18, 19, 21 and 22, of United States Letters Patent No. 2,448,063, issued on August 31, 1948, to E. Thys on an application filed August 28, 1944, to be invalid.

The appellee has appealed from the failure of the trial court to award appellee a reasonable sum for attorneys' fees incurred herein and as prayed for.

STATEMENT OF PLEADINGS AND JURISDICTION

Thys Company, a corporation, the appellant herein, filed suit against the appellee Sophie Oeste, on June 6, 1952 (R. 3) charging infringement by the appellee of claims 18, 19, 21 and 22 of the said Letters Patent, and also alleging that the appellant had given "sufficient notice to the public that said articles are patented by fixing to the packages wherein one or more of them is enclosed a label containing the word 'patent', together with the number of the patent, the char-

acter of the articles being such that said notice could not be fixed to the articles themselves" (R. 4), and the appellant demanded a preliminary and final injunction against further infringement by the defendant * * *, an accounting of damages, judgment for a sum equal to three times the amount of actual damages sustained by the plaintiff, an assessment of costs against defendant, and an award of reasonable attorneys' fees (R. 3-4). Jurisdiction of the District Court was alleged upon U.S. Code Title 28, Section 1338(a) and U.S. Code Title 35, former Sections 67 and 70 (R. 3).

The appellee filed her answer on July 21, 1952, admitting jurisdiction, but denying validity and infringement and inter alia, alleged a file wrapper estoppel, and by way of a special and fourth defense the defense of license, and the appellee also prayed that the appellee be granted and awarded reasonable attorneys' fees for the defense of the action (R. 4-9).

On September 10, 1952, the appellee filed notice of additional defenses, setting forth five additional domestic and one foreign patent to be relied upon by the appellee at the time of the trial (R. 11-13).

The trial of the cause took place on January 13 and 14, 1953 (R. 45) and was submitted following the oral argument had on January 19, 1953 (R. 207-212). Subsequently, on March 4, 1953, the District Court filed its Opinion concluding the claims of the patent in suit to be invalid for want of invention (R. 20-33). The appellee filed her Proposed Findings of Fact and Conclusions of Law and the appellant on March 25, 1953, filed its Amendments and Additions to said Findings of Fact and Conclusions of Law proposed by appellee (R. 44), and thereafter on April 10, 1953, the Court

filed its settled Findings of Fact and Conclusions of Law (R. 33-39).

On June 1, 1953, the District Court filed its Final Judgment adjudging the claims in suit invalid and dismissing the complaint with prejudice; said judgment being entered on June 2, 1953 (R. 40-41).

On June 30, 1953, the appellant filed its Notice of Appeal (R. 40-42) and, on July 1, 1953, the appellee her Notice of Cross-Appeal (R. 42).

The jurisdiction of this Court is based upon U.S. Code, Title 28, Section 1291, and the appeal on the part of the appellant and the cross-appeal on the part of the appellee were taken within 30 days of the entry of judgment of the District Court, pursuant to the provisions of the Federal Rules of Civil Procedure, Rule 73(a).

STATEMENT OF THE CASE

The patent in suit issued to E. Thys, President and Treasurer of the appellant herein, and is entitled "MACHINE FOR STRIPPING HOPS FROM VINES." The patent issued for an alleged combination, which is claimed in the patent specification to reside "in *two* features: one, in the *bar itself* and the other in the *interlocking finger construction*" (R. 219, col. 2:8-10). The object of the patent is stated to be "to provide improved hop *picking finger* and *finger bar construction*." (Emphasis supplied.)

With respect to the first element, the "bar itself", the object is stated to be "to provide a finger bar and picking finger arrangement *obviating the use of clamps, ties, pins or other fastening means for the individual fingers*," by having "all of the fingers (being) secured to the finger bar *by a single master pivot pin* of a readily detachable character" (R. 219, col. 2:29-35). (Emphasis supplied.)

At the time of the trial the appellant disavowed this feature or element of the claimed combination, declaring it was merely the second element or feature, namely, "the interlocking finger construction", that constituted the invention. Appellant stating to the trial court that "the invention resided merely in the idea of eliminating" the clip used in the prior art (R. 28:2-5); and, "it is this partial twist that Mr. Thys invented that he was given a patent on" (R. 211:31-(212)1). Also reiterated in its Opening Brief (Op. Br. 3:17-24).

The appellee contends, among other things, that by such stipulation to the trial court the claims are conceded to be invalid as admittedly claiming more than the patentee invented. And, therefore, that there was concededly no basis for the institution of this costly patent infringement action against the appellee nor is there any basis for the prosecution of this present appeal.

The appellee also contended that the claims were invalid as (1) it was old in the art to insert a rod through helical coils (cf. Trowbridge, R. 234, Fig. 4) in order to secure or couple one member (finger) to or mount the same upon another member (finger bar); (2) it was equally as old to provide helical coils upon a device or element for the purpose of using said coils to connect the first element to a second element by the use of a connecting rod inserted through the coils.

Further, that there was no justification for the instigation of this action as the coils on the legs of the appellee's picking fingers are not provided for the purpose of securing the fingers to any other element (R. 101:10-13), nor could these coils conceivably be "adapted for slideable reception of a *finger bar*" as claimed in the patent. (R. 223, col. 9:65).

With respect to the second element or feature of the claimed combination, "the interlocking finger construction," the object is stated in the specification to be "to provide picking fingers which are mutually supporting and which flex as a unit and at the same time are readily detachable from each other and from the finger bar." (R. 219, col. 2:25-29).

Or, as more simply stated by counsel for appellant, this second element, the "interlocking finger construction" merely teaches that "the coils of the prior art patents might be used to support adjacent fingers." (R. 211:3-4).

It was the appellee's contention that it did not constitute invention to reduce the coiled interlocking finger leg construction of the prior art (cf. among others, Trowbridge (R. 233: Fig. 5.)), to a mere half twist on *each* leg of a picking finger.

And, the appellee also contended, inter alia, that as the picking finger used by the appellee obviously did not have a "complementary bend" of the type specified and claimed in the patent, or in fact any other type of "complementary bend" on *each* of the legs of her picking finger, as called for in the claims of the patent, that there was no basis for the institution of the action for infringement against her.

The appellee further contended in support of her prayer for attorneys' fees:

(1) that as the appellee's finger construction was admittedly (R. 74) the construction called for in disallowed Claim 27 (R. 74:25-30) that there was no probable basis for the charge of infringement and that the action was instigated in bad faith;

(2) that the appellant admittedly recognized at the time appellant's president (the patentee) and its attorney inspected appellee's machine in September, 1951 (R. 52:

16-20), or nine months before the action was filed, that the finger of the appellee was secured from the same source (R. 51:18-(52)20) as that from which appellant secures its picking fingers, namely, appellant's alleged licensee (R. 49; 93; 94:23-32); and, therefore, there was no basis for the bringing of this action;

(3) that the appellant, contrary to the allegations in its pleadings (R. 4), was well aware it had not given sufficient notice, or, in fact, any notice at any time whatsoever to the public or to the appellee prior to filing this action that it claimed a patent monopoly on any combination finger assembly construction (R. 95; 108:13-17); and the appellant was well aware that the appellee was not using any picking finger that had not been purchased subsequent to the date of the license agreement with the said seller-licensee; consequently, this action was brought in bad faith;

(4) that the evidence conclusively establishes that the sole and only purpose for instigating the present cause of action as well as that litigation entitled "Horst Company v. Sophie Oeste," filed at the same time, namely, June 6, 1952, and in which the patent also was held invalid, being reported in 114 F. Supp. at page 408, was to harass, annoy, worry and oppress the appellee, Miss Oeste (since deceased in April, 1954, at the age of 67), and thus force her to settle the then pending action in the trial court entitled, "Horst Company and Thys Company v. Sophie Oeste, now pending in this Court on an appeal taken by plaintiffs, being Appeal No. 13,885, inasmuch as the alleged basis for the two additional threatened infringement actions was admittedly known to the appellant and its patent counsel in September, 1951, but that said threats of action were made for the first time nine months later and only at a time when appellee's patent counsel was known to appellant to be ill and unable

for an indefinite period to give advice with respect to such charges of infringement and threatened action (R. 128:10-13; 105:2-5).

The trial court in finding the claims sued upon invalid for lack of invention, made no other findings with respect to the other defenses raised by the appellee. Such other grounds relied upon by the appellee, together with any other ground established by the evidence are, of course, available on appeal in support of the trial court's judgment holding the claims invalid.

Nor did the trial court make any finding with respect to appellee's prayer contained in her answer herein for an allowance of attorneys' fees; nor was any mention made in the Memorandum and Opinion as to why such request had not been allowed.

The appellant noticed an appeal from the judgment, and failing to designate for inclusion the complete record and all proceedings and evidence had in the action, the appellant filed pursuant to Rule 75(d) of the Federal Rules of Civil Procedure, a paper entitled "Appellant Thys Company's Statement of Points on Appeal" (R. 44; 213-214).

The four points set forth in said Statement being in the same chronological order and substance as those contained in the abortive Statement of points filed by this appellant in the pending appeal before this Court, No. 13,885.

A copy of this same Statement of points was later filed by appellant with this Court, allegedly to comply with this Court's Rule 17(6).

Subsequent to the appellant's designation of the record, the appellee filed her designation of additional contents of the record (R. 44). And, also, the appellee, pursuant to Rule 19(6) of this Court's rules filed a concise statement of the points on which she intends to rely (R. 215) on her cross-appeal.

While the appellant made no application to this Court to be permitted to do so, the appellant completely abandons its alleged four points on appeal previously filed and served, (R. 213-214) and upon which basis appellee made her designation of the record, and set forth in its opening brief (Op. Br. 20-23) 14 new and entirely different points under its specification of errors.

QUESTION INVOLVED

The appellant presents no question for this Court's consideration.

The appellant having failed to present and argue in its opening brief the points set forth in its statement of points on appeal, (R. 213-214) the same must be considered abandoned. And, pursuant to Rule 17(6) this Court "will consider nothing but * * * the points so stated."

Nor was any application made by appellant to this Court to be permitted to file a substitute or amended statement of points on appeal. Consequently the matters now taken up in appellant's opening brief are not properly before this Court.

The only question presented for review on this appeal is that presented on behalf of the appellee on her cross-appeal, namely, whether there was an abuse of discretion on the part of the trial court in failing to award the appellee reasonable attorneys' fees as provided for in Section 285 of Title 35, United States Code, and as prayed for in her answer.

SUMMARY OF ARGUMENT

1. Where the appellant fails to comply with the rules of this Court, there is nothing presented for this Court's consideration and the judgment of the trial court should be affirmed as to appellant's appeal.

2. The appellant's failure to comply with the Federal Rules of Civil Procedure as well as the rules of this Court with respect to appeal procedures cannot be considered as inadvertence or an oversight.

3. The appellee reiterates her points 1 and 2, Summary of Argument, page 5 of the Brief of Appellee, in the pending appeal entitled *Thys Co. et al. v. Oeste*, No. 13,885, namely:

"1. It is a fundamental principle of American jurisprudence that not only shall the Court be specifically advised as to the matters that it is called upon to decide by the complaining party, but that the opposing party shall also be particularly advised in such matters in order that he may be placed in a position to make reply thereto should he desire to do so.

2. The rules of this Court contain definite and mandatory provisions whereby the Court and the opposing party shall be specifically and particularly advised in all matters presented for the Court's consideration."

4. The appellant's contemptuous disregard of the orderly rules of procedure on appeal is clearly shown by its abortive attempt to place before this Court in its brief 14 new and different points on appeal all without leave of this Court first having been timely had.

5. The appellant shows a further disregard for this Court's rules in the form and substance of the now alleged 14 new points on appeal.

6. There is admittedly no merit in this appeal, the appellant concedes the claims sued upon claim more than the patentee invented.

7. The appellant having failed to include in its printed record before this Court all of the evidence before the trial court, admitted by appellant to be material to the consideration of its appeal, this Court must conclusively presume

that such evidence is unfavorable to the appellant and that the same supports the judgment.

8. The judgment of the trial court finds abundant support even in the very emasculated form of the evidence presented by appellant to this Court.

9. The confused, ambiguous and unintelligible statements of the appellant, as well as its constantly changing and shifting of position on appeal attest to the frivolous nature of this appeal, and there is presented nothing for this Court's consideration.

10. The limited record on appeal establishes numerous grounds available in support of judgment of invalidity.

11. The presumption of validity which usually attaches to issuance of a patent, completely destroyed with reference to patent in suit.

12. It is impossible to find a reported case wherein the evidence of grossly oppressive tactics and general bad faith in the instigation and prosecution of litigation exceeds that employed and exhibited by the appellant in the instant case.

13. The evidence is clear that where the Court fails to award reasonable attorneys' fees under such onerous circumstances as present in the instant case, that the public becomes very reluctant to incur the burden of the heavy legal expense necessary to challenge the validity of the grant of a patently unwarranted patent monopoly or a patent being used for oppressive purposes.

14. Section 285 of Title 35 of the United States Code recognized that patent infringement actions involve heavy legal expenditures and that a patentee does not acquire along with his patent a grant to threaten, institute and/or continue to prosecute maliciously frivolous and expensive patent litigation.

15. All of the facts in this case fully support the appellee's position that there is presented here the type of excep-

tional situation contemplated by the Statute, and that the trial court should have made an award to appellee of reasonable attorneys' fees, and to fail to do so constitutes abuse of discretion and error on the part of the trial court.

Argument

Adherence to Procedural Rules of This Court Mandatory

The appellee herein in her reply brief filed in Appeal No. 13,885, now pending before this Court between the same parties called attention to the necessity of compliance with this Court's rule and further directed attention to the added factor of gross unfairness and heavy burden that an appellee suffers when the orderly rules of appeal procedure are not complied with (Brief for Appellee, Appeal No. 13,885, pages 6-9).

Consequently, the appellee believes that the conduct of the appellant in filing its opening brief in the present appeal in as equally a flagrant disregard of this Court's rules, and, in addition, its disregard of the provisions of Rule 75(d) of the Federal Rules of Civil Procedure, must be considered as premeditated and deliberately in defiance of the decisions of this Court and the decisions of other Circuit Courts of Appeal as to the necessity of compliance with the procedural rules of the Court.

The following cases being relied upon by appellee in said pending appeal, No. 13,885, and are also relied upon herein :

Mutual Life Insurance Co. v. Wells Fargo, (9 Cir.)
86 F.2d 585, cert. den. 291 U.S. 676, 54 S.Ct. 527;
reh. den. 292 U.S. 601, 54 S.Ct 627 ;

E. R. Squibb & Co. v. Mallinckrodt, Chemical Works,
(8 Cir.) 69 F.2d 685, 687, cited with approval by
this Court in *Mutual Life Insurance Co. v. Wells
Fargo Bank*, supra ;

Humphreys Gold Corp. v. Lewis, (9 Cir.) 90 F.2d 896, 897;

Twentieth-Century Fox v. Brookside etc., (8 Cir.), 194 F.2d 846, 852;

Comm. of Int. Rev. v. O'Donnell, (9 Cir.) 90 F.2d 907, 908.

And particular attention was directed to the recent case of *KoolVent Awning etc. v. Bottom*, (8 Cir.) 205 F.2d 209, wherein the Court stated at page 214:

“* * * The points relied upon form the basis of the proceedings of this Court and their function is by analogy similar to that of the plaintiff's complaint.”

The frivolous nature of the conduct of the appellant in its pretense of compliance with Rule 75(d) as well as Rule 17(6) is clearly shown by the fact that the alleged Statement of points on appeal filed by the appellant herein comprises the same four points set forth in the same identical order and substance as that Statement of points on appeal filed in the co-pending appeal No. 13,885—R. 249, 250, and Appellee is also firmly of the opinion that it is highly improbable that the appellant ever in good faith was of the opinion that this Court adopted its Rule 17(6) merely for the purpose of receiving a Statement of points on appeal so broad and general in character as to be applicable to any number of cases.

It is believed to be a fair inference that the appellant was unable to file a proper Statement of its points because this appeal is without merit.

Appellant Presents Nothing for This Court's Consideration

The appellant in its brief has not presented its previously filed points on appeal (R. 213-214) nor has it attempted to argue such points. Such points must, therefore, be considered abandoned.

The appellant has, rather, set forth 14 entirely new and different points in its brief (Op. Br. 20-23). These new points on appeal are not properly before this Court and need not be considered by it.

This Court has stated it will not consider any points other than those set forth and filed pursuant to its Rule 17(6).

Rule 17(6) states: “* * * the appellant * * * shall file with the Clerk a concise statement of the points on appeal on which he intends to rely * * * and the Court will consider nothing but * * * the points so stated.”

In the case of *Western National Insurance Co. v. LeClare*, 163 F.2d 337 at 340, the Court held with respect to points not set forth in the required Statement:

“* * * These points were not stated in appellant’s statement of points and hence need not be considered by us * * *.”

And in the case of *Williams v. Dodds*, 163 F.2d 724 at page 725, this Court made a statement to the same effect and also cited with approval the case of *Western National Insurance Co. v. LeClare*, supra.

Nor has the appellant complied with the provisions of Rule 75(d) of the Federal Rules of Civil Procedure, 28 U.S.C.A., following 723(c). And, in that connection, the Supreme Court has stated that it does not constitute compliance with rules of this nature, where a too general and a too broad statement is filed. The Supreme Court holding as follows:

“* * * The Circuit Court held that this question was not properly raised before it because respondent has failed in appeal to make ‘a concise statement’ of the point as required by Rule 75(d) of the Federal Rules of Civil Procedure, 28 U.S.C.A., following 723(c). Respondent argues that the question was properly raised, though not specifically by its *general point* that ‘the doctrine of

res ipsa loquitur is not applicable to the facts of this case'. We cannot hold that the Circuit Court erred when it refused to consider the question because of respondent's failure to comply with Rule 75(d)." (Emphasis supplied)

Jesionowski v. Boston & M.R.R. (1947), 329 U.S. 452, 458-9; 67 S.Ct. 401, 407-8.

Further, this Court in the case of *Philip R. Park, Inc. v. Fed. Trade Comm.* (9 Cir.), 136 F.2d 428, at page 429 pointed out that the appellant had not argued the questions which they had set out in their Points on Appeal but had rather argued some points entirely different. The appellee in that case accepted the change of points and answered them in his brief. However, this Court pointed out that the mere acceptance of the points by the appellee does not necessarily mean that the Court will permit the substitution.

In the case of *Mutual Life Insurance Co. v. Wells Fargo Bank & Union Trust* (9 Cir.), 86 F.2d 585, (which case was cited by the appellee in her brief in the now pending appeal between these same parties No. 13,885) the Court directs attention to the necessity for requesting leave of this Court before the appellant is privileged to abandon his former statement of points on appeal with impunity, this Court stating as follows:

"* * * Rules of practice are necessary. If the parties, through oversight, fail in compliance therewith, they are afforded a remedy through amendment which is all sufficient to protect every substantial right. This Court has repeatedly permitted such amendments where *seasonably* sought and such accorded with the justice of the situation. This method not only amply protects the party but it preserves the helpful purpose of the appellate rules in providing orderly procedure. No request for such amendment was here made, and having failed to follow this easily available method, the

appellant is in no position to invoke the protection of Equity Rule 19." (Emphasis supplied)

Further, the additional legal expense to appellee of having appellee's counsel constantly checking and re-checking the record in the light of appellant's changing positions, especially where all of the record of the trial court is not included on appeal, can cause a real and unwarranted hardship to the appellee, which amounts to oppression.

It is submitted that the failure of the appellant to comply with this Court's rules as well as with the Federal Rules of Civil Procedure must be considered intentional and that because of such violation of the rules there is now presented nothing on behalf of this appellant for this Court's consideration.

Mutual Life Insurance Co. v. Wells Fargo etc., (9 Cir.), 86 F.2d 585 (citing many cases);

Jesionowski v. Boston & M. R. R., supra;

Bank of Eureka v. Partington, (9 Cir.) 91 F.2d 587, 589;

Rokey v. Day & Zimmermann, Inc., (8 Cir.) 157 F.2d 735; cert. den. 67 S.Ct. 1080, reh. den. 67 S.Ct. 1198;

Humphreys Gold Corp. v. Lewis, (9 Cir.) 90 F.2d 896, 897 (citing numerous cases);

Comm. of Int. Rev. v. O'Donnell, (9 Cir.), 90 F.2d 907, 908;

State of Washington v. U. S., 9 Cir., 1954, 214 F.2d 33, 45.

Further, this Court's attention is directed to the fact that even the now stated 14 new points (Op. Br. 20-23) include in most instances two to three specifications of error under each point. Also, the specification of error No. 1 (Op. Br. 20) is additionally objectionable by reason of failing to comply with this Court's Rule 18, 2(d) which provides:

“When the error alleged is to the admission or rejection of evidence the *specification shall quote* the grounds urged at the trial for the objection *and the full substance* of the evidence admitted or rejected, and refer to the page numbers in the printed * * * transcript where the same may be found.” (Emphasis supplied.)

This Court stated in the case of *Dayton etc., v. Sabra*, 63 F.2d 865, 866, “assignments of error in admitting or rejecting evidence must quote full substance of evidence—evidence not assigned according to this rule will be disregarded”.

The appellant herein in the referred to co-pending appeal No. 13,885 was also derelict in complying with this above rule of Court. See appellee’s brief in said appeal No. 13,885, pages 56-59.

Appellant Concedes Present Appeal Frivolous In Nature

The appellant states to this Court that this appeal is taken for the two-fold purpose of having this Court re-write the claims of the patent sued upon so that the same will merely claim “the use of a twist instead of a clip to join steel wire hop-picking fingers”, and to then find such re-written claims valid (Op. Br. 3:17-24).

The appellant thus reiterating to this Court its insistent assertions to the trial court that as a matter of fact the only thing the patentee really is alleged to have invented is this alleged twist. (This brief, page 5; R. 228:2-5; 211:31-(212)1).

Such stipulation as to a material fact constitutes evidence and the Court is entitled to rely upon such stipulated fact.

American Chemical Paint Co. v. Dow Chemical, 6 Cir., 164 F.2d 208;

Barkeij v. Lockheed Aircraft Corp., 9 Cir., 1954, 210 F.2d 1, 2.

The patent claims in suit are, therefore, conceded to be invalid because of claiming more than the patentee invented. Consequently, there is obviously no basis for this appeal on the part of appellant.

Material Evidence Not Placed of Record Must Be Presumed to Support Judgment Appealed From

The appellant concedes that it has not placed before this Court all of the evidence material to its appeal that was considered by the trial court.

The records and files of this Court disclose that the appellant filed on or about August 18, 1953, a partial Designation of the Contents of Record on Appeal which appellant deemed material to consideration of its appeal (said designation comprising 12 items) and completed said designation on or about November 21, 1953. The exhibits deemed material were placed under one item of this designation.

On December 21, 1953, the appellant moved this Court for its Order dispensing with the necessity of printing 21 exhibits designated as material by appellant. The appellant naturally did not make any claim of financial hardship as the basis for such a request.

The appellee opposed the motion on the grounds that the exhibits were too numerous, as well as some being quite small. Further, the appellee pointed out that the appellee's counsel had been compelled to expend considerable time and effort in assisting the Clerk's office in locating some of the original exhibits which apparently had been misplaced by the District Clerk's office, and that due to the size and number and the importance of the exhibits to the appellee, appellee was loathe to have so many exhibits handled by so many persons, especially when some exhibits could not be replaced.

This Court in denying the appellant's motion, suggested that the appellee and appellant endeavor to stipulate with respect to some exhibits that might be used in their original form.

On the same day as the hearing of appellant's motion, namely, December 21, 1953, counsel for appellee addressed a letter to the appellant's counsel looking toward carrying out the suggestion of this Court. A copy of this letter was furnished to the Clerk of this Court. Also, an additional photostatic copy was attached to the papers of appellant's counsel filed with this Court in opposition to appellee's motion to dismiss (presented to this Court on January 11, 1954), on the grounds of appellant's failure to go forward with the printing of the record. The appellee's counsel did not receive the courtesy of a reply from the appellant's counsel to this offer of stipulation and appellant thereafter secured the order of this Court with respect to the acceptance by this Court of printed Patent Office copies of the patents and permitting the appellant to submit only eleven (11) copies of the Book of Exhibits.

Thereafter, the appellant caused to be printed a record from which was omitted that evidence admitted to be material to this appeal by the appellant in its motion above referred to, which was denied by this Court, and which evidence this Court required to be printed if it was to be considered.

That such omitted evidence must be conclusively presumed as unfavorable to the appellant and as supporting the judgment of the trial court is well established. This Court stating in such cases as *Greco v. Haff*, 63 F.2d 863, at page 864 that the presumption is that exhibits not made a part of the record by appellant are unfavorable to him.

And, that where on appeal the evidence is not brought up,

the Court rules presume it supports the verdict, findings, judgment or decree.

Heffron v. Western Loan & Building Co., (9 Cir.),
84 F.2d 301, cert. den. 57 S.Ct. 189, 299 U.S. 597,
81 L. Ed. 440.

This Court also pointing out in the case of *Heffron v. Western Loan & Building Co.*, supra, that where the record before the Court of Appeals fails to show such record is a complete and entire record of the trial court's proceedings "There is nothing in it which gives any indication that *all* the proceedings before the referee or the Court have been included therein," it must be presumed that the evidence not brought up supports the judgment. The Court holding, as against the claim by appellant of lack of evidence not appearing from the record, that the Court of Appeals would presume that the district court correctly decided all issues before it which might depend on factual evidence.

Or, as particularly stated in the case of *Greco v. Haff*, supra, "Nor can we disturb the findings * * *, because at the hearing certain exhibits, consisting of printed pamphlets, were introduced in evidence but have not been incorporated in the record on appeal * * *. We are therefore precluded from reviewing this finding (*Evanoff v. Bonham* (C.C.A. 9), 50 F.2d 756); and the presumption is that the exhibits are not helpful to appellant's cause. (*Jurgams v. Seaman*, (C.C.A. 8), 25 F.2d 35, 36)."

And, in such cases as *U.S. v. Foster*, (9 Cir.) 1941, 123 F.2d 32, this Court has stated that a presumption of correctness attaches to the findings made by the district courts, and an appellant seeking to overthrow those findings has the burden of presenting a proper record to the Circuit Court of Appeals.

As the burden of establishing error in the district court's findings rests upon the appellant, it would seem axiomatic that unless all the evidence material to the question before the trial court is before the appeal court, it cannot be said that the findings are not supported by the evidence.

McColgan v. Maier Brewing Co., 134 F.2d 385, cert. den. 64 S.Ct. 37, 320 U.S. 737, 98 L. Ed. 437;

Dant & Russell v. J. D. Halsted Lumber Co., (9 Cir., 1939) 103 F.2d 306;

Wingate v. Bercut, (9 Cir., 1945) 46 F.2d 725.

Or, as held in the case of *Bank of Eureka v. Partington*, 9 Cir., 91 F.2d 587, 590, "A decision on the question thus attempted to be raised would require an examination of the evidence. The evidence is not in the record. * * * Not having the evidence before us, we indulged the presumption that it (evidence) justifies the Order which the District Court made."

The above cases are in conformity with the provision promulgated by this Court in Rule 17(6) wherein this Court states that it will consider only "those parts of the record" that have been printed. And further stating in said rule that "If at the hearing it shall appear that any material part of the record has not been printed, the appeal may be dismissed, * * *".

It is submitted that the records and files of this Court establish that the appellant herein knowingly caused material parts of the record not to be printed, and this appeal may, therefore, be properly dismissed insofar as the appeal of the appellant is concerned.

It might be well before leaving this point to direct attention to the fact that the appellant herein, also the appellant in the co-pending appeal before this Court No. 13,885, is

fully aware of the need for this requirement in the Court's rules, because at page 63 of the Opening Brief in said Appeal No. 13,885, this appellant particularly directs this Court's attention to this necessity. The appellant quotes a portion of a decision wherein the court stresses that it is only because "Each of these documents was before the trial court and is before us. * * *", that enables the appeal court to consider the matter.

And, it should be noted that the trial court in the instant case was greatly influenced by the evidence contained in the file wrapper of this patent. The trial court stating in its Opinion (R. 21) with respect to the patent in suit that "*By numerous amendments tenaciously pressed upon the Patent Office, the plaintiff's assigner finally succeeded, after four years of debate, in obtaining patent No. 2,448,063 hereinafter referred to as the patent in suit, * * * After a study of the voluminous file wrapper, the Court is of the opinion that the patent was obtained—in part, at least—by progressively narrowing the claims so that they now resemble the achievement of the German specialist who kept on learning more and more about less and less, until at last he had learned everything about nothing at all!*"

This file wrapper was one of the exhibits which the appellant omitted to have printed in the present record after this Court had denied the appellant the privilege of using only the original exhibit. Nor, did the appellant make any attempt to designate any portion of the file wrapper to be printed.

Appellant's Presently Stated Points Unintelligible And Not Argued.

The variance between the now stated 14 points on appeal set forth in appellant's brief (Op. Br. 20-23) and its argument following this statement of points is further evidence,

if such were required, that this appeal of the appellant is completely unjustified and without merit.

The confused statement of appellant's position coupled with the ambiguousness and unintelligibility of its remarks throughout its brief, are of such magnitude as to give the impression of being a studied effort on the part of appellant to cover up, if possible, the lack of a ground for this appeal, rather than being made for the purpose of advising this Court of any real prejudice suffered by the appellant.

And, not the least of the factors contributing to this confusion is that of the repeated contradictions found between the various statements and arguments of appellant.

Turning first to the variance between the points as now stated by appellant to be its position on appeal, and the argument of appellant presumably in support of such points.

While appellant's brief is replete with variances of this nature, appellee will not burden this Court with their complete enumeration, believing the following will suffice for purposes of illustration.

1. The appellant (Op. Br. 24) set forth a sub-heading under Argument which relates to the province and jurisdiction of this Court under the provisions of Rule 52(a) of the Federal Rules of Civil Procedure. However, under this heading, other than making one small reference to the fact that this rule does not preclude this Court under certain circumstances from reviewing documentary evidence, the appellant argues matters pertaining to the use of expert witnesses at the time of trial. The appellant stating (Op. Br. 25), "And in this case, we find that the expert was guilty of misinterpreting the most pertinent prior art disclosure."

The argument, therefore, under this point, as nearly as appellee can understand it, appears to be directed to the point of whether or not it lies within the sound discretion of

the trial court to determine when a given case or situation calls for expert opinion. There is no assignment of error remotely resembling one pertaining to the abuse of discretion of the Court in this connection. The confused statements of appellant throughout this discussion make it absolutely unintelligible to the appellee.

2. The need for strict compliance with this Court's rule with respect to the assignment of error as to the admission or rejection of evidence namely, Rule 18, 2(d), wherein it is specified that—

“When the error alleged is to the admission or rejection of evidence the *specification shall quote the grounds urged* at the trial for the objection and the *full substance of the evidence* admitted or rejected, and refer to the page numbers in the printed * * * transcript where the same may be found,” (emphasis supplied)

is succinctly pointed up in the appellant's present abortive specification of error No. 1 (Op. Br. 20).

In the first place, no assignment of error remotely resembling this point was made by appellant in its Statements of Points on Appeal. Secondly, the record clearly establishes that the appellant's counsel withdrew appellant's objection to the testimony of the expert, Mr. Trabucco (R. 137), stating that “there is no harm except it takes” up time. And, stating again to the trial court, “We have no objection in the slightest to this witness testifying how such and such a thing on such a patent works * * *.” (R. 138:16-18). As a result, the abortive specification of error 1 of appellant (Op. Br. 20) and its argument are so wholly at variance as to render this entire specification of error completely incomprehensible and unintelligible.

State of Washington v. U. S., 9 Cir., 1954, 214 F.2d 33,
45.

It might be well at this point, however, to direct this Court's attention to the totally unwarranted, unfounded and uncalled for remarks and insinuations of appellant with respect to the witness Mr. Trabucco.

Mr. Trabucco is a man of the highest standing in his profession. He has been a patent attorney for 30 years (R. 133); has enjoyed the distinction of being appointed by the court as a master, rendering opinions concerning the validity and infringement of patents (R. 133). To insinuate as the appellant has (Op. Br. 17) that Mr. Trabucco would have his opinion influenced merely because he received a fee for his work is grossly unjust, unfounded and unwarranted. The remarks of appellant with respect thereto are all the more unjustified when it is considered witnesses who receive only the statutory fee are those witnesses that are compelled by law to testify.

If any witness had an ulterior motive in giving his testimony it was admittedly the appellant's president, Mr. Thys, the patentee. And, in fact, little credit can be placed in the testimony of this witness. Mr. Thys' testimony is replete with contradictions.

The remarks with reference to the expert witness Mr. Trabucco are as groundless as was the bringing of the present action against the appellee, and as baseless as this appeal on the part of the appellant.

3. Nor is there to be found any consistency between specification of error 2 (Op. Br. 21), with reference to the trial court's finding 4, and the argument addressed to such finding 4 (Op. Br. 28). The statement of point appears to contain two assignments of error, one assignment apparently directed to whether the yardstick or principle applied as a basis for the finding was correct and the other as to whether there is any evidence in the limited record placed before this court for making the finding.

However, the argument, as near as appellee's counsel is able to determine, seems to be addressed solely to whether the term "scheme of advancing scientific knowledge," used by the trial court, comes within the Constitutional language "to promote the Progress of Science and Useful Arts." This, of course, is not an argument that the finding of invalidity is unjustified on the record that was before the trial court.

Then appellant goes off on the point of "utility" and appears to be urging that a device need only be found to have "utility" to be considered an invention (Op. Br. 28-29). That if a device is the result of merely mechanical skill it cannot have "utility"; that the results of mechanical skill and "utility" are adverse terms. In any event, the argument is so at variance with the abortive specification of error 2, as to make the whole completely confused and ambiguous to the appellee.

4. And so it is throughout the abortive 14 points as stated by appellant—all equally unintelligible, incomprehensible and at variance with the ambiguous statements set forth in its brief under the caption "Specification of Errors" (Op. Br. 20-23), as near as the appellee is able to determine.

However, before leaving this subject, it might be well to note one more of the most flagrant variances. This is found in specification of error 5 (Op. Br. 21), addressed to the trial court's finding 7, wherein it would seem that appellant is urging that the prior patents referred to in finding 7 do not disclose a picking finger having a V-shaped picking portion; do not disclose a picking finger having parallel legs; or a picking finger having means to anchor the finger to a finger bar; nor had the referred to prior patents disclosed picking fingers arranged in row formation on a picking finger bar, or the further disclosure of having the legs of adjacent picking fingers coupled together. The finding

clearly states that the trial court found such features to be disclosed in the referred to prior art patents and that as a consequence such features must be considered old in the art.

Apparently, it is the appellant's position that the trial court should not have made any finding with respect to what the Court considered to be disclosed in the prior art. Appellant's argument under this specification renders the language of the specification even more ambiguous and unintelligible by urging that the finding was either a broad or a narrow construction of the claims in suit, and that a finding with respect to the prior art was erroneous and that the trial court erred in making any finding with respect to the prior art.

And, as the appellant on this appeal concedes, "All of the mechanical devices required to make up the Thys combination were old in this case, as they were in the companion case, Appeal No. 13,885" (Op. Br. 9:14-16), it becomes even more incomprehensible as to just what the appellant is urging with respect to this particular abortive specification of error.

Perhaps it would be just as well, at this point, to note that the statements in appellant's brief (Op. Br. 44-45) with respect to Conclusion of Law 2 are unwarranted and unfounded. For, while the Court did find in accordance with the provisions of Section 103, Title 35, United States Code, with respect to the subject matter set forth in the claims as a whole, it was not necessary for the trial court to have done so in view of appellant's stipulation to the trial court that the invention resided "merely in the idea of eliminating the clips on the tops of the fingers."

In the case of *John B. Stetson Co. v. Stephen L. Stetson Co.*, C.C.A. N.Y., 133 F.2d 129, the court pointed out that

a party cannot successfully claim an error which he, himself, is responsible for or rulings which he has invited the trial court to make.

Or, as in the case of *American Chemical Paint Co. v. Dow Chemical* (6 Cir., 1947), 164 F.2d 208, the Court pointed out in permitting the certification of a portion of the record containing a transcript of the argument of counsel, that where counsel in his argument relating to facts or procedure makes a stipulation, such stipulation is binding on the litigant whom he represents. (Cf: *Barkeij v. Lockheed Aircraft Corp.*, 9 Cir., 1954, 210 F.2d 1, 2).

It is submitted, therefore, that the appellant has neither properly placed before this Court its now stated 14 points on appeal, nor has the appellant argued such points, but has argued completely different points, not set forth in either its original statement of points on appeal or in its now abortive 14 points on appeal. Consequently, there is presented nothing for this Court to review on behalf of the appellant.

Appellant's Efforts to Suppress Evidence Supporting Judgment of Invalidity Unavailing.

That the four claims of the patent at issue herein are clearly invalid in view of the prior art is evidenced from but a cursory review of the very limited record that the appellant has seen fit to present to this Court, as well as the testimony of the expert Trabucco (R. 133-200) with respect to these disclosures.

The abundance of this evidence now about to be referred to by appellant, also adds to the incomprehensibility as to wherein the appellant could possibly find any error in the judgment of the court in holding the four claims of the patent invalid.

Taking the elements of the claims at issue in the order in which they are listed by the appellant in its Chart set forth in its Opening Brief (Op. Br. Appendix A):

1. "V-shaped picking portion."

That this element is old and was well known long prior to the claimed invention at issue is clearly established by but a slight glance at the following references, which the patentee Thys must have been well acquainted with: HORST, Patent No. 1,008,914 (R. 285: Fig. 11); HORST, Patent No. 1,012,135 (R. 293: Fig. 2); HORST, Patent No. 1,054,122 (R. 297: Fig. 3); HORST, Patent No. 1,054,119 (R. 302: Fig. 12); HORST, Patent No. 1,054,551 (R. 314: Fig. 13); MILLER, Patent No. 2,139,029 (R. 353: Fig. 6).

And a V-shaped picking portion for a hop picking finger is also disclosed in prior art patent issued to TROWBRIDGE, Patent No. 968,001 (R. 233: Fig. 4, Fig. 5) and it is also found in the British patent to GRAY, Patent No. 512,540 (R. 260: col. 1; col. 2: claim 4).

The designation of the element as a V-shaped picking portion states its function succinctly and establishes that such element performs the same function in the prior art patents just referred as it performs in the present combination.

2. The feature described in the present claims as having the side arms of the picking portion extended to form legs or arms is found even in the early patent to Moore, Patent No. 562,504, issued July 7, 1896 (R. 363: Fig. VIII) showing such extension of a U-shaped picking portion.

V-shaped picking portions so extended as presently claimed by the 'Thys' patent in suit are to be found in the following references: THYS, Patent No. 2,191,183 (R. 254: Fig. 4); GRAY, Br. Pat. No. 512,540 (R. 258: Fig. 4); HORST, Patent No. 1,008,914 (R. 283: Fig. 6); HORST,

Patent No. 1,012,135 (R. 293: Fig. 2); HORST, Patent No. 1,054,122 (R. 297: Fig. 3); HORST, Patent No. 1,054,119 (R. 302: Fig. 12); HORST, Patent No. 1,054,551 (R. 314: Fig. 13); MILLER, Patent No. 2,139,029 (R. 353: Fig. 6).

The following prior patents also disclosed the feature of extending the picking portion of a picking finger into parallel legs or arms: TRAPHAGEN, Patent No. 1,358,481 (R. 368: Fig. 1); LIVERMON, Patent No. 1,776,736 (R. 347: Fig. 2); HARRINGTON, Patent No. 1,350,452 (R. 276: Fig. 4); HARRINGTON, Patent No. 1,035,437 (R. 269: Fig. 2).

These references to the prior art, taken with the sound testimony of the expert Trabucco as to their disclosures and functions, makes it obvious that these parallel leg portions perform the same function in these prior art references as the parallel leg portions perform in the claims of the patent before this Court.

3. Likewise, the feature of providing means on the leg portion of a picking finger to anchor the said finger to a finger bar is disclosed in numerous references of record. And even to the extent of having the bar removable to detach a damaged or broken finger.

In the patent to TRAPHAGEN, No. 1,358,481 (1920) (R. 369), the very same thing which Thys claimed in his specification of the patent in suit as an improvement, namely, "the fingers being secured to the finger bar by a single master pivot pin of readily detachable character," was stated in 1920 in the patent issued to TRAPHAGEN (R. 369) as being old. The statement being in the following language in this TRAPHAGEN patent (R. 369:19-35):

"* * * it is now common practice to mount the rake teeth (fingers) on these bars (finger bars) with the

spring coils of the teeth encircling their respective rake bars. This construction necessitates passing a rake tooth lengthwise over a rake bar, or rather, stringing the teeth on a bar. It follows, therefore, that in case any rake tooth (finger) is injured or broken during use, as frequently occurs when the rake is drawn over uneven obstructions or for other reasons, it becomes necessary to remove one or more rake teeth. This can be done only by removing all of the rake teeth from one end or the other of the rake bar at the side of the injured tooth to remove the latter. * * * (parenthetical inserts supplied)

In other words, to provide the type of means called for in the patent in suit (R. 219, Col. 2:33-35; 220, Col. 4:35-45) whereby you would be required to withdraw a rod or pivot pin from all of the fingers up to, say, the middle finger on the rod or pin, in order to repair or replace the middle finger, is to provide the same device which was old in 1920, and considered inefficient at that time.

The patent to Traphagen, supra, was not cited by the Patent Office against the claims in suit. Consequently, the presumption of their validity is destroyed.

As in the co-pending appeal No. 13,885, we have the appellant herein claiming invention by means of retrogressing.

However, it is significant to note here that the appellant admits that it was well aware that the appellee uses the means disclosed in the early patent to MOORE and WELLER (1896) (Op. Br. 9:25-(10)5) and not that of the patent in suit, to anchor appellee's fingers to a finger bar.

In the patent to LIVERMON, No. 1,749,040 (R. 342, Fig. 2) the bar element 25 is shown to be inserted through the spring element 13 of the picking finger in order to anchor the finger. This figure of the drawings referred to clearly

illustrates the use of a coil spring on the leg of the picking finger for the purpose of anchorage.

This patent to Livermon was not cited against the patent at issue herein by the Patent Office (R. 224).

And, of course, the British patent to GRAY, No. 512,540, teaches such a construction (R. 258:Fig. 4).

Then, too, the patent issued to THYS, 2,191,183 (R. 254) discloses such an element, especially in Figs. 2, 3, 4, and 5.

The patent issued to MORRIS, No. 1,704,805 likewise has a similar disclosure (R. 246: Fig. 11). The Patent Office also failed to cite this reference of the prior art (R. 342).

And, means for anchoring of a similar element to a rod or bar is also disclosed in the patent to TROWBRIDGE, Patent No. 968,001 in Fig. 4, being element 5 anchoring element or part "g" (R. 234: Fig. 4).

Such anchoring means is also disclosed in the patent to FERGUSON, Patent No. 912,835 (R. 228: Fig. 5).

Now, if this element, "the specific rod and finger arrangement of the Thys' patent" (Op. Br. 9:25) is given the scope insisted upon by the appellant (R. 100; 19-34) i.e., any coil that may conceivably be adapted to receive a pivot pin constitutes the specific element or rod disclosed by Thys, then the following references must be considered as disclosing such an element: HARRINGTON, Patent No. 1,035,437 (R. 269: Fig. 2); HARRINGTON, Patent No. 1,350,452 (R. 276: Fig. 4); LIVERMON, Patent No. 1,158,248 (R. 327: Fig. 7); LIVERMON, Patent No. 1,744,806 (R. 335: Fig. 9); LIVERMON, Patent No. 1,776,736 (R. 347: Fig. 1); MOORE and WELLER, Patent No. 563,504 (R. 363: Figs. VII-VIII); TRAPHAGEN, Patent No. 1,358,481 (R. 368: Figs. 1, 2, 3).

From the above it is obvious why the appellant conceded in the trial court and on this appeal that the above referred

to elements performed no different or added function in the present "Thys' combination" (Op. Br. 9:15) than said elements or parts performed in the prior art and was therefore most desirous that the invention be considered as residing only in the elimination of the clip disclosed in the Horst prior patent.

4. Turning now to that element of the combination claim calling for complementary bends to couple similar adjacent legs of a picking finger by hooking them together.

There can be no dispute but that the prior patent to TROWBRIDGE, Patent No. 968,001 (R. 233: Fig. 5) discloses the coupling of two legs of a finger by twisting them together.

Now, it must be kept in mind that the element so far stated merely calls for bends whereby "each leg may be coupled to similar adjacent legs" and, certainly, two legs of one picking finger are adjacent to each other. So it is clear that Trowbridge teaches the joining of two adjacent picking finger legs together by twisting.

The appellant particularly conceding this by stating "We find the Trowbridge patent in 1910 which had two legs of a picking finger twisted together * * * and then we find in the old barbed wire patent in the 1880s, which involved a spur on a piece of wire, because the barb was held in place by twisting two wires together" (R. 210:12-19) and, further, stipulating that "so twists were well known" (R. 210:20).

Now in the particular claims before this Court the patentee then goes on to recite that these complementary bends just referred to are to "include(ing) a partial encirclement of a finger by an adjacent finger". The significant word in this qualification found in the claim is the word "including". The claim is indefinite as not specifying what

else it includes besides the partial encirclement of an adjacent finger. It would appear from the reading of the claim that the two legs of a single picking finger might well be twisted together and then encircled by another finger.

Then if it be assumed, without conceding the same, that the claims mean to state that one leg of one picking finger is twisted around a similar leg of an adjacent finger, the twisting of such similar legs of two or more picking fingers together, is the same as taught by Trowbridge with respect to the legs of a single finger.

In other words, does it amount to invention over the prior art disclosure of twisting similar legs of one picking finger together to twist similar legs of adjoining fingers together?

The Patent Office Examiner considered the disclosure in Fig. 5 of the Trowbridge patent (R. 233) as teaching the method of connecting adjacent legs of picking fingers with each other by interlocking and twisting of the legs (R. 190:15-23).

And, it might be well to observe at this point that it has long been established that where an applicant for a patent discloses in his application a device that must inherently do a certain thing, he necessarily discloses that function, or that thing, even though he says nothing concerning it. Consequently Trowbridge teaches the appellant's construction.

Brand v. Thomas, 96 F.2d 301.

Or, as stated in the case of *In re Reynolds*, 109 F.2d 654, 656, the fact that the patent does not contain a claim covering diglycerids is not important insofar as the use of the invention is concerned. *The test is disclosure.*

cf: *Celite Co. v. Decalite*, (9 Cir.) 96 F.2d 242-248;
DeForest v. Gen. Elec. Co., 283 U.S. 664, 682, 686, 51 S.Ct. 563.

The patentee Thys, and president of the appellant, conceded (R. 103:9-17) that he was well acquainted with the old type of Horst picking finger (Def. Exh. C) and had seen the adjacent legs of such picking fingers connected to each other by means of homemade twists or the twisting of the legs together in the manner shown in Trowbridge, Fig. 5 (R. 233), and the fingers aligned along a finger bar in such a manner (R. 103).

The appellant is careful not to direct this Court's attention to this knowledge on the part of Thys. Rather, the appellant keeps insisting and reiterating over and over again that nothing new had been done in this field for 30 years. However, we see here, that men who make no claim to being mechanics, but are merely the growers of hops, adapting this well known principle (of securing two elements together by twisting them) without any difficulty or claiming it amounted to invention.

All the appellant claims for the patent in suit is that Thys reduced this homemade twist to a half-twist. And then the appellant concedes that such a reduction is old (Op. Br. 9:14). Each element is conceded to be old, including this half-twist (R. 211:3).

The next question is whether any of the mechanical devices or elements found in the present combination claims perform any new or different function out of the combination than they do in the combination. There is no evidence of record of any new function or result. The trial court, therefore, correctly found that the "mechanical devices required to make up the Thys' combination" perform no new and different function than they had performed in the prior art and that such combination was merely the summation of its parts, and that it would have been obvious to any one having the prior art before him at the time of the invention and, upon the principles enunciated by the

Supreme Court in the cases referred to, held the claims invalid for lack of invention.

In the recent case (1953) of *Shell Development Co. v. Pure Oil Co.*, 111 F. Supp. 197, the court in a similar fact situation as found herein stated as follows:

“A logical step forward to be considered by anyone experimenting in the field, which accomplished no new or unexpected result, although of economic importance, is not a patentable improvement. (*Universal Oil Products Co. v. Globe Oil & Refining Co.*, 312 U.S. 417, 64 S.Ct. 1110, 88 L. Ed. 1399; *Vanadium Corp. of America v. Marzall*, 91 U.S. App. D.C., 197 F.2d 187; *Minnesota Mining and Mfg. Co. v. Coe*, 99 F.2d 986). For anticipation is not necessary to show that the inventor had actual knowledge of the prior art. (Citing *Millett v. Allen*, 27 App. D.C. 70). * * *”.

Or, as held in the case of *American Cyanamid Co. v. Marzall*, (1952) D.C. Cir., 196 F.2d 24 at page 25: “* * * the public cannot be deprived of an old process because someone has discovered that it is capable of producing a better result, or has a wider range of use than was before known. See also *General Electric Co. v. Jewell Co.*, 1945, 326 U.S. 242, at p. 248, 66 S.Ct. 8, 90 L. Ed. 43.” This case also cites for its authority the case of *Lovell Manufacturing Co. v. Cary*, (1893) 147 U.S. 623, at page 624, 13 S.Ct. 472, 476 38 L. Ed. 30.

The Supreme Court in the case of *Smith v. Hall*, 57 S.Ct. 711; 81 L. Ed. 1049 points out that it is immaterial that the structure employed in the early use was neither the best that could be obtained nor as skillfully designed or used as that later employed by the patentee; these factors are not material on the question of validity of a patent for want of invention.

This Court in the case of *Parker Appliance Co. v. Irwin W. Masters, Inc.*, 9 Cir., 193 F.2d 180, held that if an improvement is to obtain the privileged position of a patent, more ingenuity must be involved than the mere work of a mechanic skilled in the art. To have reduced the homemade twist to a mere half twist is conceded to be old (Op. Br. 9) and would not even involve the skill of a mechanic in the art. It is admitted that a twist is nothing but an extended coil (R. 211:3).

And it has been repeatedly held in such cases as *In re Smith*, 262 F. 717, a claim cannot be allowed for a construction disclosed in a prior patent which would inherently accomplish applicant's purpose whether it was the intention of the prior patentee to make such a disclosure or not. Consequently, it is totally unimportant whether or not Trowbridge (R. 232) intended to use the twisting of the adjacent legs of the individual picking finger (R. 233: Fig. 5) for the same purpose that the homemade twists (R. 103:9-17) were utilized by the growers in connection with the old Horst type of picking finger (Def. Exh. C) (with which the patentee Thys was familiar) in order for the disclosure of Trowbridge to be considered as prior art.

Also, as stated in such cases as *In re Fink*, 62 F.2d 103, it is not necessary that a prior patent disclose how to make the disclosed article or device in order to have the disclosure considered as a good reference against the monopoly sought for its use by an alleged later inventor.

And in the case of *Cutter Laboratories v. Lyophile-Gryochem*, 9 Cir., 179 F.2d 80, this Court stated that where a process has been fully disclosed in the prior art without full appreciation of all its valuable attributes the perception of new advantages in the old process does not constitute invention.

In the case of *Autographic Register Co. v. Uraco, Inc.*, 182 F.2d 353, 355, the Court held it is not necessary that the inventor of a prior invention have the use to which his invention is put by the subsequent patentee in mind in order to have the prior invention considered as prior art.

And, as the trial court stated with respect to this patent in suit the language of the Supreme Court in *Great Atlantic & Pacific Tea Company v. Supermarket Equipment Company*, 340 U.S. 147, 71 S.Ct. 127, 95 L. ed. 162, is equally applicable here:

“* * * A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men. The patentee has added nothing to the total stock of knowledge, but has merely brought together segments of prior art and claims them, in congregation as a monopoly.”

The Supreme Court in this *Great Atlantic & Pacific case*, supra, endeavored to make it quite clear that the court was only reiterating what the Supreme Court felt it had made abundantly clear in its previous decision of *Lincoln Engineering etc. Co. v. Stewart-Warner*, 303 U.S. 343, 58 S.Ct. 662, 82 L. ed. 1008, wherein it was stated:

“The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function that that heretofore performed or produced by them, is not patentable invention. (citing numerous cases).”

With respect to this legal principle the appellee also relies upon all the other cases cited in the co-pending appeal between these same parties, No. 13,885, such as *Photo Chart v. Photo Patrol*, 9 Cir., 189 F.2d 625, and the more recent cases of *Kwikset v. Hilgren*, (9 Cir., 1954) 210 F.2d 483, 486,

Stearns v. Tinker & Razor, S.D. Cal. 1952, 108 F. Supp. 237, and *Skoog et al. v. McCray Ref. Co.*, (7 Cir.) 211 F.2d 254, 257.

In this recent case of *Stearns v. Tinker & Razor*, supra, it was again pointed out that every grant of a patent is a grant of a privilege of exacting tolls from the public, and an invention to justify such a privilege must make a distinctive contribution to scientific knowledge.

**Presumption of Validity of Patent
Herein Completely Destroyed.**

As to the weight to be given to the presumption of validity, even where it has not been destroyed as in the present case, the very recent case of *Robertson v. Digaetano*, 5 Cir., May, 1954, 212 F.2d 1, (which cites the case of *Pacific Marine Supply Co. v. A. S. Boyle Co.*, 9 Cir., 103 F.2d 288,) the court therein stated at page 3, as follows :

"We think there remains for consideration only appellant's suggestion that the Patent Office having sustained the device over the Houseman patent, the district court was not entitled 'to override the legal presumption and judgment of the Patent Office in favor of the Robertson patent over a cited reference.' While the presumption of validity which normally attends the issuance of a patent by the Patent Office is somewhat strengthened by its consideration and rejection of the patent relied upon to establish anticipation * * * it is nevertheless our province to determine when, as here, that presumption has been overcome. The *concurring opinion* of Mr. Justice Douglas and Mr. Justice Black in the *Great A & P Tea Company* case, supra, 340 U.S. 147, 71 S.Ct. 132, states that the ultimate 'question of validity of a patent is a question of law' for the Courts and that admonition should make us mindful of our duty to restrict upon judicial review 'the pressure to extend monopoly to the simplest of devices.' 340 U.S. at pages 155, 156, 71 S.Ct. at 132." (emphasis supplied)

However, it is well settled that where the Patent Office fails, as it did in the present case, to cite pertinent prior art that the presumption of validity is destroyed. And this court has so held.

Stoody v. Mills Alloys, 9 Cir., 87 F.2d 807;

Mettler v. Peabody Engineering Corp., 9 Cir., 77 F.2d 56;

McClintock v. Gleason, 9 Cir., 94 F.2d 115;

Gomez v. Granat Bros., 9 Cir., 177 F.2d 266;

O'Leary v. Liggett Drug Co., 6 Cir., 150 F.2d 656;

Norman Products Co. v. Sequoia Manufacturing Co.,
N.D. Cal. (1952) 107 F. Supp. 928.

The Patent Office having cited (R. 224) only the following prior art patents: FERGUSON (R. 225); TROWBRIDGE (R. 232); MORRIS (R. 238); THYS (R. 253) and GREAT BRITAIN (Gray) (R. 257), the presumption of validity is completely destroyed in view of the very pertinent prior art references relied upon by the appellee, referred to above. Especially is the Patent Office's failure to cite TRAPHAGEN, No. 1,358,481, (R. 369:15-30) significant in view of Traphagen's statement that the means of aligning one element adjacent to another on a bar or rod arrangement for anchorage was old and not too efficient in 1920!

It is difficult to think of a situation where the picturesque remarks quoted by Justice Lamm of the Missouri Supreme Court in the case of *Mackowik v. Kansas City*, 196 Mo. 550, 94 S.W. 556, with respect to the destroying of this type of presumption could be more applicable:

"Presumptions * * * may be looked on as the bats of the law, flitting in the twilight, but disappearing in the sunshine of actual facts."

Record Abounds in Grounds Supporting Invalidity.

The evidence before this Court even in its very limited form also discloses evidence sufficient to support the trial court's judgment of invalidity of the claims on many other grounds besides that upon which the trial court rested its judgment, namely, lack of invention.

In fact, it might be said that the record presents an embarrassment of riches (evidence) of invalidity. This abundance of grounds in support of invalidity of the claims adds to the incomprehensibility of the appellant's now alleged points on appeal and its argument.

And, of course, these grounds are available on appeal in support of a correct judgment or decree.

Peterson v. Coast Cigarette Co., 9 Cir., 131 F.2d 389;
Helvering v. Gowran, 302 U.S. 235, 245, 58 S.Ct. 154,
 158, 82 L. ed. 224.

The record and the opening brief of appellant are replete with stipulations to the effect that the patentee has over-claimed his invention. The appellant consistently insisting that the invention resides in the "twist instead of a clip to join steel wire hop picking fingers." (R. 28:2-5; Op. Br. 3) or, "it is this partial twist that Mr. Thys invented that he was given a patent on." (R. 211:31-(212)1).

As the claims call for a considerable number of other old "mechanical devices" (Op. Br. 9) and are not limited to the mere use of the old "mechanical device" of using "the coils of one of the prior art patents" as stated by appellant (R. 211) to eliminate the clip, the claims are conceded invalid as claiming more than the patentee invented.

Cf: *Great Atlantic & Pacific Tea Company* case, supra, at page 150, 340 U.S.; 71 S.Ct. at 129, citing *Bassick Mfg. Co. v. R. M. Hollingshead Co.*, 56 S.Ct. 787, 791, and *Carbice Corp. v. American Patents Dev. Corp.*, 51 S.Ct. 334.

Also, where a material element is omitted from the claimed combination, as it is in the present patent, the patent is invalid. No means is recited in the present claims whereby the picking finger is prevented from rotating around the finger bar when the machine is in operation. Such rotation would make the machine inoperative.

cf: *Great Atlantic & Pacific Tea Company case*,
supra,

with respect to "clarity required of claims which define the boundaries of a patent monopoly (citing cases)."

Further, the claims are ambiguous, indefinite and incomplete and therefore invalid on this additional ground. The claims recite a complementary bend "including a partial encirclement" but fail to specify any thing else that the bends are alleged to be *including*. Also the claims recite such partial encirclement is of a *finger* of an *adjacent finger* but do not recite the means for accomplishing such encirclement or its method. Consequently the claims cannot be said to meet the clarity required of claims in order to define to the public the boundaries of the patent monopoly claimed.

cf: *Great Atlantic & Pacific Tea Company case*,
supra;

Jacquard Knitting Machine Co. v. Ordinance Gauge Co., 213 F.2d 503, at 506;

Application of Welch, 213 F.2d 555, 560;

Application of Schechter, (1953) 205 F.2d 185, 187.

The above do not constitute all of the grounds of record of invalidity that are available on appeal.

M. Swift & Sons v. W. H. Coe Mfg. Co., 1 Cir. 102
F.2d 391.

The trial court placing its decision on the broad ground of lack of invention, stating it was unnecessary to pass upon the other issues.

Inapplicability of Appellant's Cited Authorities Additionally Confusing.

Appellant makes reference (Op. Br. 25) to a number of authorities cited by this same appellant in co-pending Appeal No. 13,885, without stating their applicability to the point attempted to be made. The referred to authorities are summarily incorporated by appellant with no more than “* * * plaintiff adopts the rulings * * *.” Since the inapplicability of the cited cases to any point attempted to be made in Appeal No. 13,885, is equally true in the instant case, the entire reference is doubly confusing.

The appellee has carefully read and analyzed the appellant's authorities. However, their applicability to any factual situation conceivably involved herein completely eludes the appellee. And, as the appellant has utterly failed to state wherein the appellant finds any such similarity between the facts of the present case and that of the cited reference, and wherein such authorities are contrary to the principles upon which the trial court held the claims of the patent at issue invalid, the appellee does not deem it necessary to burden this Court with a discussion of such unrelated authorities.

Further, the fact that the appellee has been unable to discover any possible merit whatsoever in the confused and ambiguous statements of the appellant with respect to its abortive points on appeal and alleged arguments in support thereof, a discussion of the appellant's cited authorities would appear only to add to the confusion already present in the entire brief of appellant.

The authorities of the appellee cited herein and those relied upon in the co-pending appeal No. 13,885, so completely support the judgment in both of these appeals that it is obvious that any authorities to the contrary must be distinguishable on their facts.

Consequently, the inapplicability of appellant's cited authorities add to the unintelligibility engendered by the contradictory statement of appellant's alleged grievances and lend support to the thought that this confusion was intentionally created in an effort to conceal the very frivolous nature of this appeal.

Section 103 Correctly Interpreted and Applied Herein by Trial Court

The authorities cited by the appellant with reference to the scope and effect of the provisions of new Section 103, Title 35, United States Code, are fully answered in the appellee's brief in co-pending appeal, No. 13,885, as follows:

“Section 103 particularly specifies that the Court shall test the validity of a patent by determining whether: If ‘a person having ordinary skill in the art to which said subject matter pertains’ had all the prior art before him at the time the patent was applied for would ‘the subject matter as a whole’ of the alleged invention have been obvious?

“(This section being but a practical test of the Constitutional requirements that for the patent monopoly the invention must contribute something additional to the science and arts.)

“The record in this case establishes clearly and unequivocally that the answer to the above question is in the affirmative.” (Brief for Appellee, Appeal No. 13,885, pp. 12-13).

(And the evidence of the homemade twist in the instant case (R. 103) also clearly establishes that such construction would have been obvious.)

“That Congress did not intend that the new Section 103 was anything more than a codification of the principles previously enunciated in such cases as the *Great Atlantic & Pasific Tea Company case*, supra; *Lincoln Engineering Company of Illinois v. Stewart-Warner Corporation*, supra; *Photochart v. Photo Patrol*, (9 Cir.) 189 F.2d 625, *Parker Appliance Co. v. Irwin W. Masters, Inc.* (9 Cir.) 193 F.2d 180; *Kalich v. Patterson Pacific Parchment Co.*, (9 Cir.) 137 F.2d 649, 651, 652 and cases decided on the principles of law set forth in these cases is succinctly pointed out in the case of *Stanley Works v. Rockwell Mfg. Co.*, (3 Cir.) (1953) 203 F.2d 846 (citing the decision of the present case with approval at page 849) in the following statement:

“On its face Section 103 is merely a codification of decisional patent law. The report of the Senate Committee on the Judiciary (Vol. 38, No. 8 Journal of Patent Office Society of August, 1953) leaves no doubt about this. In part that report states:

‘Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a variety of ways in decisions of Courts and in writings. Section 103 states this requirement in the title. * * *’

“And, all cases decided subsequent to January 1, 1953, (effective date of Section 103), reiterate that this Section 103 adds nothing new.

New Wrinkle v. Watson, (D.C. Cir.) 204 F.2d 35;

New Wrinkle v. Watson, (D.C. Cir.) 206 F.2d 421; cert. den., 74 S.Ct. 767;

Rock-Ola Mfg. Corp. v. Cusano, (3 Cir.) 206 F.2d 551;
Allied Wheel Products, Inc. v. Rude, (6 Cir.), 206 F.2d 752;
United Mattress Mch. Co. v. Handy Button Mch. Co., (3 Cir.) 207 F.2d 1;
Osborne Mfg. Co. v. Newark, (D.C. N.J.) 111 F. Supp. 846, 850; •
Joseph Bancroft & Sons. v. Brewster etc. Co., (D.C. N.Y.) 113 F. Supp. 714; and
Lyons v. Construction etc. Co., 112 F.S. 317.”

(Brief for Appellee, Appeal No. 13,885, pp. 18-20.)

Discernible Arguments of Appellant of Frivolous Nature.

At every conceivable point throughout its brief, particularly under its Statement of the Case, appellant keeps putting forward the doctrine of long felt need. In fact, the consistency with which the appellant brings forth this doctrine lends considerably to the confusion created in that it makes each argument appear as if it is nothing but a reiteration of the previous argument. There is, however, no evidence of record of any long felt need in the present case. The only evidence of the use of this finger is that of the appellant's witness Westlake. Mr. Westlake stated that the alleged infringing picking finger was not used on the large picker drums carrying the great majority of the picking fingers used by the appellee, but was only used on the arm picker and four small jump drums (R. 203:15-26).

And, the appellant's witness Kauth testified that the new fingers were not interchangeable with the old (R. 119-120). Consequently, it is evident that it was necessary for the appellee to purchase sufficient fingers to replace all the fingers on a given small picker drum or arm picker when the

old Horst type of picking finger was no longer available on the market.

In fact, this testimony establishes that the new finger is only purchased to the same extent that the old finger was purchased, namely, for replacement of broken fingers.

Nor was any evidence adduced that the appellant received any royalties under the alleged license agreement with Moxee City Warehouse (Rivard) to substantiate any such wide use which would naturally be attendant upon any long felt need being satisfied.

The holding in the recent case of *Application of McCarn*, (1954) 212 F.2d 797, at 799 is particularly applicable on this point.

cf. *Toledo Pressed Steel Co. v. Standard Parts Co.*,
307 U.S. 350, 59 S.Ct. 897, 83 L. Ed. 1334, 1338.
Application of Felburg, (1954) 211 F.2d 597.

Further, it is believed that for the appellant to avail itself of such doctrines as this and at the same time to have suppressed from the record such contemporary patents as that issued to Rivard (Moxee City Warehouse) the appellant appears to be having its cake and eating it too! Surely, if the appellant is permitted to urge to this Court that no one else but Mr. Thys thought of this idea of connecting picking fingers by twisting together their adjacent legs, then in all fairness the appellant should be allowed the reference Rivard, No. 2,428,321 (R. 30) to rebut this contention. The very fact that the Rivard patent was applied for within three months of the filing date of the patent at issue, indicates that there was some other reason why all of a sudden there was an interest in developing a new finger. It is believed that where the appellant relies upon such doctrine as this that it is incumbent upon the appellant to place of record the manufacturing conditions, the market demand,

etc., to establish that there were no market difficulties, no manufacturing difficulties or anything else that entered into the failure to place upon the market the device alleged to have met a long felt need.

The remarks of the Supreme Court in the *Toledo Pressed Steel v. Standard Parts* case, supra, are most applicable to the present situation.

In any event, it is the position of the appellee that the provisions of Rule 52(a) preclude this Court from giving consideration to such borderline doctrines. For certainly it cannot be said that the findings of the trial court are clearly erroneous if resort must be had to such borderline doctrines which are conceded to be applicable only in very close questions of validity. Therefore, it is believed that the only proper place for the weighing of and giving consideration to such borderline doctrines is in the trial court.

Equally fallacious in nature is the appellant's assertion (Op. Br. 19) that the appellee's counsel only agreed to finding 8 (R. 37) after the Court had ruled in her favor with respect to the showing in the Trowbridge patent (R. 232).

Inasmuch as the appellant had originally designated for inclusion in this record "Plaintiff's Amendments and Additions to Findings of Fact and Conclusions of Law", but later failed to include them in the record without permission of this Court, the appellee has placed them of record at this time by incorporating the same in this brief and placing them in the appendix hereof.

These proposed amendments (Appendix I of this brief) clearly establish that the appellee, in the interest of settling the findings and conclusions without undertaking a trip to Sacramento, conceded the narrow interpretation placed upon the Trowbridge showing by the appellant. However, the appellee has never agreed that Fig. 5 of Trowbridge

(R. 233) does not teach the joining of two adjacent similar picking finger legs whether they be of the same finger or of an adjacent finger. The appellee merely conceded the finding to be in accord with the statement of the Court contained in its Opinion which was referred to by the appellant in its suggested amendments.

It is believed, for the appellant to have made any reference to the proposed findings of the appellee; the findings as finally settled, etc., when the appellant had failed to print such necessary documents in the record herein, was for the purpose of distortion and misleading this Court.

In any event, there is no foundation for this argument of appellant (Op. Br. 19).

Perhaps nothing illustrates the frivolous nature of this appeal better than the remarks of the appellant (Op. Br. 2) wherein the appellant even endeavors to make an issue out of the fact that the appellee in her answer availed herself of the provisions of Rule 9 of the Federal Rules of Civil Procedure. The appellant urging that there is a "diametric conflict," (which appellee does not concede) between the defense of license and the appellee's prayer that the patent in suit be declared invalid and void.

And, the appellant (Op. Br. 20) urges to this Court that by such pleading this Court is to consider it as "evidence warranting the inference that she (appellee) deems the defense to be one of little worth."

It is difficult to conceive of any statement that could be more correctly construed as an admission on the part of the appellant that its appeal is frivolous than this unjustified and unwarranted abuse of the appellee for availing herself of the provisions of Rule 9 of the Federal Rules of Civil Procedure.

Trier of Facts Is Weigher of Evidence.

In the present case the trial court (R. 27:5) specifically stated that its opinion was arrived at "after a careful consideration of the testimony and the exhibits * * *".

This Court, with every other court, has so long held that the appellate court cannot weigh evidence and resolve doubts concerning conflicting testimony, that a citation of an authority for such a proposition seems hardly necessary.

Gillis v. Gillett, 9 Cir., 184 F.2d 872;

Columbia National Life Insurance Co. v. A. Quandt & Sons, 9 Cir., 154 F.2d 1006.

And this Court has particularly held that where the admissions and testimony of an *interested* party make a case of conflict of testimony, the effect of such testimony must be determined by the trier of the facts.

State Farm Insurance Co. v. Porter, 9 Cir., 186 F.2d 834.

A review of the limited record before this Court on appeal with respect to the testimony of the patentee Thys, President and Secretary of the appellant corporation, reveals so many contradictions that all conflicts must be resolved in favor of the judgment, the credibility of this witness having been passed upon by the trial court.

For example: on direct examination (R. 48:11) the witness Thys testified that, with respect to the complementary bends claimed in the patent, these "little crooks on the legs of the finger bar which appear near the angle of the fingers" are the complementary bends. This was with reference to the appellant's exhibit (Pl. Exh. 7-7A) which was alleged to be an embodiment of the finger assembly disclosed in Fig. 2 of the patent (R. 218).

However, on cross-examination in testifying with respect to the finger identified as the appellee's finger (Pl. Exh. 11 and 11A) this witness Thys said that the straight leg of the appellee's finger, i.e., that leg which merely has a bend at the juncture of the leg with the picking V-portion, likewise had a complementary bend on it. The witness contended that this "angle of the finger" was actually the same as the "little crooks" (R. 62:15-30).

Then, later, on being shown the embodiment of the old Horst finger (Def. Exh. C) the witness Thys reversed himself again and stated that the bend at the juncture of the leg with the V-portion of this straight leg finger was not a complementary bend (R. 85:12-25).

Here we have the president of the appellant corporation admitting that he is well aware that the "little crooks" or complementary bends referred to in his patent are "near the angle of the finger" but are not the angle of the finger. However, in order to charge the appellee with infringement the president of the appellant corporation states that the straight leg with the angle at the juncture of the leg with the V-portion constitutes a complementary bend which is required to be on *each* leg of his finger in accordance with the claims.

Next, we have this witness stating on direct examination that the advantage of eliminating from the picking bar assembly the use of "clamps, ties, pins or other fastening means" is the object of his invention and is accomplished by the use of a pivot pin or assembly bar (R. 48:219: Col. 2).

Then we have this witness stating on cross-examination that the appellee's method of having a hook attached to the end of a finger and this hook being inserted into a wooden finger bar with a metal strip across the top of such finger bar, and metal staples used to secure the strip to the finger

bar to fasten the fingers individually is the same as the means called for in his claim (R. 61-62).

It is interesting to note that on redirect-examination (R. 96-97) that this witness, by means of very leading and lengthy questions to which the witness was only required to answer "yes", went even further in throwing overboard its alleged improvement of anchoring means in an effort to establish that the appellee's finger was the same as that disclosed and described in the patent in suit.

It is reiterated, that the above reference to the testimony of the witness Thys is but a small portion of the many contradictions found throughout the record with reference to this witness' testimony.

Consequently, only the trial court can determine the credibility of this witness from the witness' demeanor, etc., with respect to the remainder of his testimony.

And, it should no doubt be observed at this point that the appellant's counsel's attempt to discredit the expert witness Trabucco was unavailing.

The appellant on the very meagre record presented by it argues that the expert Trabucco did not understand the teaching of the Trowbridge patent with respect to Fig. 5 (R. 232). However, it is significant to note that appellant's counsel (R. 190:15-23) endeavored to suppress the fact, by constantly interrupting the witness, that the Patent Office examiner agreed with the expert Trabucco that this Fig. 5 does teach the joining of adjacent legs by twisting and interlocking. And the appellant did not place before this Court in the printed record the file wrapper of the patent, after having designated it, to show exactly what the Patent Office examiner found with respect to this Fig. 5 of Trowbridge (R. 233), nor did the appellant place before this Court any

portion of that file wrapper with reference to the claims in suit.

Further, this might be as well as any point to direct this Court's attention to the fact that while the appellant has much to say about the absence of first-hand knowledge on the part of the expert Trabucco with respect to the equipment involved, the appellant finds no difficulty in this regard with respect to the Patent Office examiner, who it is doubtful had any first-hand experience at all, even to having seen such type of equipment even once. And, it would also appear that the appellant's counsel likewise has had little experience with this type of equipment. We find counsel making such remarks as he does not understand what is meant by a jumper drum or arm picker (R. 203) and similar remarks throughout the transcript; such as quarreling with the expert Trabucco for using the word "similar" (R. 198) and then employing the same term in describing the device to the Court (R. 211:24-30).

CONCLUSION.

It is submitted that the appellant having failed to comply with this Court's rules on appeal as well as Rule 75(d) of the Federal Rules of Civil Procedure, has presented nothing for this Court's consideration and, further, in view of the over-abundance of the evidence in support of the trial court's findings, conclusions and judgment that the claims of the patent in suit are invalid, judgment of the trial court on this issue of invalidity should be affirmed.

Cross-Appeal

Appellee's Specification of Errors.

Appellee's Statement of Points on Appeal (R. 215-216) and specification of errors upon which appellee relies are as follows:

I. That the plaintiff-appellant herein was guilty of inequitable and unconscionable conduct by the instigation of this action; (This brief, p. 54)

II. That the plaintiff-appellant admittedly was aware that the patent sued upon was of doubtful validity; (p. 56)

III. That the plaintiff-appellant was aware that the Patent Office had refused and disallowed a claim admittedly covering the identical structure of the alleged infringing device; (p. 64)

IV. That the sole purpose or primary purpose in instigating this action was to vex, harass and oppress the appellee with a multiplicity of patent suits; (p. 66)

V. That the plaintiff-appellant was aware or should have been aware that the alleged infringing devices were purchased from a licensee of the appellant; (p. 70)

VI. That the lack of probable cause in the instigation of the action and the manner in which the action was prosecuted, makes it manifestly unjust and grossly inequitable that the appellee should be left to bear the heavy burden of appellee's counsel fees; (p. 74) and

VII. That the trial court erred in refusing to appellee findings of fact and conclusions of law awarding reasonable attorneys' fees to appellee, and erred in the omission of an award of reasonable attorneys' fees to the appellee in the final judgment. (p. 77)

Appellee's Argument in Support of Appeal Points.

The appellee will now discuss the above points on cross-appeal in their numbered order.

I

Section 285, Title 35, United States Code, (former Section 70) provides that the prevailing party may be

awarded reasonable attorneys' fees in exceptional cases.

The new wording of this section is but a codification of the principle previously established by case law for the exercise of judicial discretion in making such an award, namely, an "exceptional" case.

In defining the word "exceptional", it has been held that such a case has been made out where the facts establish that the losing party has been guilty of some inequitable or unconscionable conduct, or unfairness or bad faith in the conduct of the litigation, or some other inequitable consideration, which makes it grossly unjust that the prevailing party be left to bear the burden of his own counsel fees.

Blanc v. Spartan Tool Co., 178 F.2d 104;

Dubil v. Rayford Camp & Co., 184 F.2d 899 (9 Cir.);

Park-in Theatres v. Perkins, 9 Cir., 190 F.2d 137;

Brennan v. Hawley Products Co., 98 F. Supp. 369.

And bad faith or inequitable conduct on the part of the losing party is established where the evidence shows that there was an awareness on the part of the plaintiff that there was no justification for bringing the action; where the primary purpose of the action was to vex, harass and oppress the defendant or prevailing party; where the patent is of doubtful validity and known to be so by the plaintiff, and similar situations. All as held in the immediately preceding cited authorities.

The record herein establishes that all of the above mentioned circumstances exist in the present case. The plaintiff-appellant was well aware that the patent sued upon was of doubtful validity on many grounds; that the Patent Office had refused and disallowed a claim admittedly covering the identical structure of the alleged infringing device; that the plaintiff-appellant recognized the source from which the appellee secured her fingers to be that of the admitted

licensee of the appellant; that the appellant admittedly threatened this infringement action and brought the same under circumstances which clearly establish that the threats of the suit and the actual filing of this suit simultaneously with the filing of the third action entitled *E. Clemens Horst Company v. Sophie Oeste*, 114 Fed. Supp. 408, said action also being decided in favor of the appellee (Horst Company is the other appellant in the co-pending appeal No. 13,885 between these parties) was for the sole purpose of trying to force a settlement in the previously filed case, now appeal herein as No. 13,885, between these parties.

II

That the patent in suit was well known by the appellant to be of doubtful validity on a number of grounds is well established by the record herein.

First, the patent was known to be invalid by the appellant on the grounds of over-claiming the invention (see this brief, pp. 5, 17), the appellant disavowing invention in anything but the "twist * * * this complementary bend." (R. 211:31); (R. 28); (Op. Br. 3):

E. V. Prentice Co. v. Associated Plywood Mills, (D.C. Or.) 113 F. Supp. 182, 183, 186;

Great Atlantic & Pacific Tea Co. case, supra, 340 U.S. at page 150, 71 S.Ct. at page 129;

Patent Valve Co. v. Robertsham-Fulton etc. Co., 6 Cir., 1954, 210 F.2d 146 at 152.

Second, the appellant was well aware that the patent was invalid as claiming more than the patentee invented on additional grounds, namely, on the grounds that the claims were admittedly so broad as to cover the means of securing or anchoring a picking finger to a finger bar by "the use of clamps, pins, ties or other fastening means for the individ-

ual fingers," which method of securing the fingers the patentee particularly represented to the Patent Office he was obviating (R. 219; col. 2:31-32). As a consequence, it could not be said that the patent was regularly and duly issued as it did not meet the requirements of Section 33 of Title 35 of United States Code, as a condition precedent to the patent grant by particularly pointing out to the Patent Office wherein the invention resided (New Section 112, Title 35, U.S.C.).

And, as stated in the recent case of *S. D. Warren Co. v. Nashua Gunned and Coated Paper Co.*, 1 Cir., 1953, 205 F.2d 602 at 605: "The obvious purpose of this doctrine is to prevent a patentee from obtaining a monopoly over a wider area than he has pioneered."

Cf. *Patent Valve Co. v. Robertsham etc.*, supra.

The patentee Thys, president of the appellant corporation, in company with his herein patent counsel, visited the appellee's ranch in September, 1951 (R. 52) and observed the method employed by the appellee for securing her picking fingers to a picking bar. And the appellee's method *did* employ "the use of clamps, ties, etc."

Therefore, both the appellant and the appellant's counsel were aware that the claims of the patent were invalid if they were drawn so broadly as to "obtain(ing) a monopoly over a wider area than he (Thys) has pioneered."

If, on the other hand, the patentee Thys and his patent counsel appreciated that this method employed by the appellee was not within the scope of the claims, then there was no basis for bringing the infringement action, and it was admittedly brought in bad faith.

However, the appellant at the trial insisted that this method of securing appellee's picking fingers to the finger

bar was the method which was covered by the claims of the patent in suit (R. 223 (Claim 19) col. 9:65-67).

Another, or *third ground*, upon which Claim 19 of the patent in suit is invalid for lack of clarity required by the patent statutes (35 U.S.C.A., Section 33 (New Section 112)) is the appellant's contention at the time of the trial that the appellee's finger bar structure contained all of the "mechanical devices" (Op. Br. 9) required to make up the claims of the patent in suit. The patentee Thys, as well as appellant's patent counsel who processed the application which matured in the Letters Patent at issue herein, were aware from but a casual observation of the appellee's machine at the time of their visiting her ranch (R. 52), that the appellee's finger bar structure could not even be modified to resemble the alleged invention of the patent at issue.

It was obvious to the appellant and its counsel that the appellee's picking fingers are not provided with coils on the legs for the purpose of securing the fingers to any other element (R. 101:10-13), nor could the coils conceivably be "adapted for slidable reception of a *finger bar*" as claimed in the patent, especially Claim 19 (R. 223, col. 9:65).

And, any attempt to substitute the method of merely inserting the finger bar (which would have to be changed to one round in form; rather than rectangular as presently used by the appellee) slidably through the hollow coils, provided on the legs of the appellee's picking finger, for the present method used by the appellee for anchoring her fingers to a finger bar (consisting of hooking the individual fingers into a rectangular wooden finger bar, placing a continuous metal strip over the top of the finger bar and over the fingers so hooked and then attaching the metal strip to the finger bar by means of metal staples driven through the metal strip into the wooden finger bar, thus individually

securing in a relatively fixed position each picking finger to the finger bar), would make the appellee's machine inoperable; the fingers would perform no useful function as they would then move or rotate around the finger bar (rod) by the pull of the vines, rather than remaining, as provided in appellee's machine, in a substantially fixed position whereby the fingers will be caused to comb or snare the hops free from the vines as the vines are pulled past the drums to which the finger bars are attached.

It is clear, therefore, that the appellee's device did not and does not embody all of the "mechanical devices" alleged to comprise Thy's alleged invention (R. 61:26-(62) 4). Although Thys did endeavor to give the impression to the trial court that complete anchoring means as called for in his claims was to be found on the appellee's finger structure (R. 59-61; 66:20-(67)9; 86:24-32).

Therefore, we have the appellant either admitting that the claims are invalid as not meeting the requirements of the patent statutes and known to it to be insufficient for lack of clarity. (*Application of Schechter*, 1953, 205 F.2d 185 at 187, holding that the former Section 33 of Title 35 U.S.C. and new Section 112 of the same title are in practical application the same), or, on the other hand, we have the appellant admitting that it was well aware that the appellee's structure did not come within the provisions of the claims of its patent and there was no probable cause for the instigation of this present action.

Further, Mr. Thys, the brother-in-law of E. Clemens Horst, Jr., the other appellant in the co-pending appeal No. 13,885, has long been aware of the legal principles upon which the two patents involved in this appeal and Appeal 13,885, entitled *Thys Company and Horst Company v. Sophie Oeste*, were declared invalid. Consequently, if the

holding in the case of *Lincoln Electric Co. v. Linde Air Products Co.*, 74 F. Supp. 293 at 294 is sound, then the converse must be sound, namely, that where the decisions of the Supreme Court are of long standing upon which a patent is held invalid, a patentee is under a duty to scrutinize his claims with respect to such legal principles.

In the case of *E. Clemens Horst Company v. Gibbens & Blodgett*, D.C. Cal. 50 F. Supp. 607, particular attention was directed to the principles enunciated in the *Lincoln Engineering case*, supra, and, appellant's counsel is familiar with the *Great Atlantic & Pacific Tea Company case*, supra, as well as the *Toledo Pressed Steel v. Standard Parts*, supra, as established in *Photochart v. Photo Patrol*, 9 Cir., 189 F.2d 625.

In fact, the appellant admitted it was well aware that the patent in suit did not meet the test laid down by the Supreme Court in the *Lincoln Engineering case*, supra, and the authorities referred to in the immediately preceding paragraph, but was gambling on some ill conceived notion that these cases were decided at a time when "*it was very fashionable for patents to be held invalid*" (R. 208) or at a time when "*patents were persona non grata*" with the courts, and that in 1952 the appellant, pursuant to this announced theory, was of the opinion that "*in our economic system the pendulum*" had swung in its favor (R. 208:16-(209)3;27:15).

It is, therefore, abundantly clear that the appellant oppressed the appellee herein, and continues to oppress this appellee on an admittedly frivolous concept of the place that case law occupies in our judicial system.

The patentee Thys likewise was particularly aware that the patent was of doubtful validity on a *fourth ground*. Mr.

Thys failed to disclose to the Patent Office his knowledge that homemade twists (R. 101), were used in the same manner as Trowbridge, Fig. 5 (R. 232) to join the adjacent legs of adjacent picking fingers of the old Horst type (Def. Exh. C). For, while his specification goes into considerable detail to build up the alleged Thys' invention by reference to certain prior art devices and patents, it is significant that no mention is made of this practice (homemade twists) by the growers.

Further, on Mr. Thys' direct examination no reference is made of the use of these homemade twists to the trial court, nor is any explanation offered for this omission after his knowledge of the same was brought out on his cross-examination (R. 103). Such as, that Mr. Thys was of the opinion that inasmuch as the same was not covered by any prior patent to the Horst, Thys, or Miller patentees that he did not consider it prior art, although ample opportunity was afforded him to do so if he had any such explanation, or any other explanation whatsoever that he could make in good faith.

Consequently, to have represented to the trial court as well as to the Patent Office that he, Mr. Thys, was the first person to have ever conceived of the idea of eliminating the method of joining picking fingers by removing the clip and twisting the fingers together was known to him to be false.

Fifth, the patentee Thys was aware of the doubtful validity of his patent in claiming more than he invented with respect to slidability.

It is significant to note that the structure of the bends as called for in the claims of the patent in suit contain adverse terms. The claims speak of "interlocking" at the same time speaking of "slidability." (Claim 21) (Op. Br.

Appendix A). To interlock something prevents it from being slidable. The fingers might be rotated out of an interlocked position, they cannot be slidably removed from one another.

Cf: *Patent Valve Co. v. Robertsham etc.*, 210 F.2d 146 at 152.

That Mr. Thys, the patentee, appreciated this defect in the claims of his patent is shown by his reluctance to operate the model of three picking fingers (Def. Exh. D) made up in conformity with the illustration of Fig. 2 of the patent in suit (R. 218). Mr. Thys made it quite clear that his invention apparently resides in something quite different in nature from Fig. 2 of his patent because he objected on the grounds that he was not familiar with this particular device (R. 76-79).

This defect in the Thys structure is admitted also by the appellant by the fact that the appellant does not use the type of finger illustrated in this model of three picking fingers (Def. Exh. D) and the alleged embodiment of the Thys' invention (Pl. Exh. 7-7a) of record herein (R. 48). But, rather, the appellant uses the same type of finger as the appellee and one which is admittedly an embodiment of rejected Claim 27 which the Patent Office rejected on the basis of the previously rejected claims of the application as well as Gray in view of Trowbridge (R. 74:25-30).

The appellant's bad faith with respect to this rejected Claim 27 is discussed in following point III on appellee's appeal.

Sixth. As the means for joining the fingers one to another and the means for anchoring the fingers on a finger bar have no interdependency, but are separate and distinct as to function, the claims are invalid.

Cf. *Dukes v. Bauerle*, 41 F. 778, 780, 781.

That this ground of invalidity was well known to the appellant is also established by the appellant's repeated insistence that the anchoring means be read out of the claims.

It is submitted, therefore, that the appellant was well aware that there was no basis for the institution of the patent infringement suit against the appellee and that the same was done in bad faith.

While this Court stated in the case of *Dubil v. Rayford Camp & Co.*, 184 F.2d 899, 9 Cir., that it appeared to the Court that only the United States could bring an action to invalidate or cancel a patent which was procured by the practice of fraud on the Patent Office, nevertheless this Court felt that where such fraud was found by the Court it was sufficient to support a grant of reasonable attorney's fees to the prevailing party on the basis that the plaintiff knows that it is not justified in bringing a patent infringement suit.

Where the patentee, as in the present instance, invalidates his own patent by disclaiming all but one element of a combination of old "mechanical devices" (Op. Br. 9) which were originally alleged to make up the invention and are set forth in the claims sued upon, as well as where a patentee, as herein, suppresses and fails to present to the Patent Office the fact of such general practice in the art of homemade twists of joining fingers together and thus eliminating a clip, it must be found that the patentee practiced fraud on the Patent Office in the first instance.

The trial court in holding the claims in suit invalid on the broad ground of lack of invention, did not pass upon the above referred to additional grounds of invalidity. However, the appellee is entitled to have this Court consider

the same on this appeal. (cf: authorities cited, this brief page 41:12)

III

The patentee, president and secretary of the appellant corporation herein, admitted at the trial that the appellee's finger structure, which appellant alleged was an infringement of its Letters Patent, was in fact the same structure as that set forth in rejected Claim 27 in the application for the Letters Patent (R. 73:24-(74)12).

And, the record further establishes (R. 74:21-30) that the Patent Office disallowed this structure in the following language:

“The entry of the amendment filed under Rule 78 is not recommended on the ground that the claims presented do not patentably distinguish over the structure of the references Gray taken in view of the patent to Trowbridge and the *previously rejected claims*.” (R. 74:25-30) (Emphasis supplied).

The patentee Thys acquiesced in this rejection and the patent was issued without any such claim.

Nothing could be clearer—the *appellee's* alleged infringing structure was found by the Patent Office to be nothing more or less than a modification of the British patent issued to Gray (R. 258) taken with Trowbridge (R. 232).

And, in making this rejection, it is also significant to note that the Patent Office directed particular attention to the fact that Claim 27 was rejected on the same ground as “the previously rejected claims” that had attempted to cover the structure of the appellee's alleged infringing finger.

Now, it should be remembered that this factual situation was well known both to the president of the appellant corporation and patentee, and its counsel herein; appellant's

counsel being the same counsel that processed the application that matured into the Letters Patent in suit.

Consequently, when Mr. Thys in company with his counsel herein visited the appellee's ranch in September, 1951 (R. 52) they were both well aware that the appellee's finger was the finger structure which the Patent Office had refused to grant a monopoly upon to Mr. Thys; namely, Claim 27, inter alia.

Therefore, it cannot be denied that either the appellant brought the action in bad faith, well knowing that the alleged infringing structure was not covered by any claim of the patent in suit, or, the conduct of the appellant in insisting that his claims cover the alleged infringing structure of the appellee's device, has thereby admitted that the patent was irregularly issued. As two things equal to the same thing are equal to each other and the claims at issue are all invalid and were known to Thys to be invalid as being nothing more nor less than rejected Claim 27 (R. 73: 24-(74)12).

In any event, it constituted more than unconscionable conduct on the part of the appellant in charging the appellee with infringement under the above circumstances.

It might also be well to note at this point that in the very recent case of *Application of Dufault*, 214 F.2d 181, at 184, the Court directs attention to the duty of the patentee to study carefully the claims as issued in his patent and, moreover, that it is the further duty of the appellant or patentee where he does not understand the language of his claims to call upon an expert to explain them. This *Dufault* case, of course, deals with reissue. However, if a patentee in seeking a reissue of his patent is under a duty to study his claims at the time the patent is issued and to employ expert

counsel if he does not understand them, surely then a patentee, before he involves another person in as expensive litigation as this has been, has even a greater duty to study his claims and secure expert advice in the event he does not understand them.

This above referred to evidence on the part of appellant, with respect to rejected Claim 27, clearly establishes bad faith of the highest order on the part of the appellant in bringing the present infringement action as well as prosecuting the present appeal. And the appellee submits that this evidence standing alone establishes an abuse of discretion on the part of the District Court in failing to find and award the appellee reasonable attorneys' fees in this action as it is well within the type of exceptional case referred to in Section 285, Title 35 U.S.C., and the cases interpreting this section.

IV

That the sole or primary purpose which motivated the appellant in instigating this action was to vex, harass and oppress the defendant-appellee with a multiplicity of patent suits is well established by the record herein. The abundancy of this evidence establishes that the present case is a most exceptional case and therefore makes the provisions of Section 285, Title 35, U.S.C., providing for the allowance of reasonable attorney fees to the prevailing party, almost mandatory.

The appellee will not burden this Court with a detailed statement of all this evidence, but will direct this Court's attention to only one small portion which, even standing alone, is more than sufficient to establish the bad faith on the part of the appellant in instigating this action.

Before specifically pointing out this evidence, reference is made to the fact that it has long been well established

that due notice to the defendant requires the same facts as constitutes sufficient notice to the public. Where plaintiff relies upon notice to the defendant, "proof must be made no less definite and certain than that required where he elects to rely upon notice to the public." And such notice must be given to the defendant personally in the same manner as required for the service of a complaint.

Smith v. Dental Products Co., 140 F.2d 140, 152;

Parker Rust Proof Co. v. Ford Motor, 23 F.2d 502, 503.

That the appellant herein was and is well aware of the showing required (by the above authorities) to establish notice to the public of its claimed patent monopoly is attested to by the allegations found in its complaint on file herein (R. 4(5).) Consequently, the appellant's reason for placing of record the evidence about to be referred to completely eludes the appellee. However, it is significant to note that for whatever purpose this evidence was offered by appellant it does succinctly disclose the real motive behind the appellant's action in bringing this infringement suit against the appellee.

Mr. Townsend, the patent counsel who processed the application which matured into the Letters Patent in suit, and one of the counsel herein for the appellant, testified (R. 105) that he and Mr. Thys (the patentee), on September 5, 1951 (R. 52) visited the appellee's ranch in connection with the co-pending appeal No. 13,885, in the company of a draftsman from his (Mr. Townsend's) office, together with a photographer from the Curry shop (Sacramento), and at that time (September 5, 1951) he and Mr. Thys observed the alleged infringing finger of the appellee involved in this present action.

Mr. Townsend admitted however that it was not until March 10, 1952 (R. 105:24) that any mention was made of

this alleged infringement, and that such mention was made only at a time when he (Mr. Townsend), was aware that patent counsel for the appellee was ill and unable for an indefinite period of time to give advice with respect to any such charges of infringement and threatened action (R. 128: 10-15). And no explanation was offered by Mr. Townsend for the nine months delay between the time of observing the finger i.e., September 5, 1951, and March 10, 1952.

However, on cross-examination of Mr. Townsend, his subconscious revealed the purpose for making the charge of infringement at a time when patent counsel was not available (R. 107). Mr. Townsend, in being questioned as to any notice that he had given patent counsel for Miss Oeste, between September 5, 1951 and March 10, 1952 relative to this charge of infringement, replied that he had not because he recalled "that all matters concerning *settlement* were to be referred to Mr. Curtright." This testimony is as follows:

Q. You had not at any time after September 5, 1951, until the date of the commencement of the action notified White & White that Miss Oeste was *infringing* a picking finger patent, Mr. Townsend?

A. I don't recall that I did, Mr. White. Your recollection may be better than mine on that. I do, however, recall that all matters concerning *settlement* were referred to Mr. Curtright by your office.

Q. Yes, but my question was directed to the fact whether or not you actually advised White & White that the defendant was infringing a picking finger.

A. I don't recall.

Q. (Continuing): * * * prior to the commencement of this suit?

A. That is correct." (Emphasis supplied)

During Mr. Townsend's direct testimony as well as his cross-examination (R. 104-109) there was no evidence offered that Miss Oeste, herself, as required by the patent statutes, had ever been personally contacted; nor had the

patent numbers ever been given or referred to during any conversation at any time with counsel then representing Miss Oeste; or had anything remotely resembling adequate notice been given.

However, as stated above, whatever the purpose of offering this evidence was on the part of the appellant, it is clear that it does establish that the real motive in bringing this action was to force settlement of the then pending action between these parties through the threat of vexatious litigation.

Further, Mr. Thys testified (R. 51-52) that when he saw the appellee's alleged infringing picking finger (Pl. Exhs. 11-11a) on her ranch on September 5, 1951 that he recognized the picking finger as being one manufactured by the California Spring Company "who manufacture the fingers for Moxee City Warehouse" (R. 51-53). Thys also testified that he was familiar with the Moxee City Warehouse finger (Pl. Exh. 8) which he first saw in 1950, prior to entering into an agreement with the Moxee City Warehouse in 1950 (R. 131:11-25).

The appellant offered no explanation for the delay of nine months before even mentioning the matter of the finger to the appellee's general counsel in Sacramento, at a time when patent counsel was ill. The explanation obviously resides in the fact that the patentee Thys was well aware when he first saw the finger, September 5, 1951, that it was from his licensee and there was no basis for a charge of infringement (R. 49-52).

Thereafter, the appellant filed the present action together with the action entitled *E. Clemens Horst Co. v. Sophie Oeste*, 114 F. Supp. 408, which latter action was also decided in favor of the appellee herein and the patent in suit declared invalid.

This action, *E. Clemens Horst Company v. Sophie Oeste*, supra, was not appealed. However, it is significant to note that in this second action brought by E. Clemens Horst Company against Miss Oeste, the patent involved was the same with respect to which the District Court at Sacramento had previously expressed grave doubts regarding its validity, in the case of *Horst Company v. Gibbens & Blodgett*, D.C. Cal. 50 F. Supp. 607.

In fact, looking at the litigation record as a whole with respect to the appellant herein (Mr. Thys is the brother-in-law of Mr. E. Clemens Horst), it does give rise to a surmise that there has been an attempt on the part of these litigants to prolong the benefits flowing from the early Horst patents by the securing of the "gadget" type of patent that has now been held invalid by the Courts. Nevertheless, as understandable as this motive may be, it cannot be condoned, much less encouraged.

It is submitted that this evidence of using a threat of infringement actions in an attempt to force a settlement in pending litigation between the parties establishes bad faith of the highest order and that there was an abuse of discretion on the part of the District Court in failing to award the appellee herein reasonable attorneys' fees as prayed for.

V.

There was absolutely no probable cause for the bringing of the action on the alleged infringing structure, as appellee purchased all of the alleged infringing picking fingers from an agent of appellant's licensee.

Now, as set out above, Mr. Thys, the patentee, and his patent counsel herein immediately recognized the appellee's picking finger on September 5, 1951, as being the finger sold by Moxee City Warehouse (R. 49-41). As the appellant was well acquainted with this finger (only one year before

the visit to the appellee's ranch), with infringement of the patent in suit by the sale of said type of finger.

The record establishes that all but 24 picking finger bars (R. 123-124) were purchased by the appellee after March 10, 1950, the date of the license agreement (R. 131) between Moxee City Warehouse and the appellant, and the record further establishes that the appellee purchased all of the alleged infringing picking fingers from an agent of Moxee City Warehouse, namely, Kauth Bros., of Santa Rosa, California (R. 203; 119:16-21).

There is no evidence of record that the appellant did not receive its royalties on the alleged infringing picking fingers purchased by the appellee from appellant's licensee after March 10, 1950. And under the agreement (R. 131), it must be assumed that such royalties were paid, as the agreement particularly states the royalties shall be paid on all fingers *purchased* after March 10, 1950. And, also, the agreement further provides that the appellant shall receive *a copy of all the purchase orders* under the agreement. There is no evidence of record either that the appellant did not receive a copy of the appellee's purchase orders from its licensee Moxee City Warehouse.

As stated by the United States Supreme Court in *Interstate Circuit v. United States*, 306 U.S. 208, 226, 59 S.Ct. 467, 83 L.Ed. 610, "Silence then becomes evidence of the most convincing character. (Citing numerous cases)." Or, as held by the United States Supreme Court in the case of *Kirbey v. Talmadge*, 160 U.S. 379, 383, 16 S.Ct. 349, 40 L.Ed. 463, "All evidence * * * is to be weighed according to the proof which it was in the power of one side to have produced and in the power of the other side to have contradicted." Or, as also held by the United States Supreme Court in the case of *Clifton v. United States*, 4 How. 242, 247, 11 L.Ed. 957, 959. "The production of weak evidence when strong is

available can lead only to the conclusion that the strong would have been adverse.”

If Moxee City Warehouse had been remiss in forwarding any royalty payments to the appellant, it was a matter between the licensee and licensor and not one involving the appellee third party. The appellee in purchasing her fingers from an authorized agent of the licensee of the appellant was entitled to rely upon the holding out to the public that the agent was entitled to sell the fingers under the license agreement of March 10, 1950 (R. 131).

Once the royalty is provided for, the device is free of the patent monopoly and there is no basis for a charge of infringement.

Hobbie v. Jennison, 149 U.S. 355, 362, 13 S.Ct. 879, 880, 37 L.Ed. 766, 768;

U. S. v. Univis Lens Co., 313 U.S. 241, 252, 62 S.Ct. 1088, 1094, 86 L.Ed. 1408;

Jackson v. Vaughan, 9 Cir., 73 Fed. 837, 839.

Next, turning to the 24 bars purchased by the appellee prior to the license agreement between the appellant and Moxee City Warehouse, namely, the purchase made on July 15, 1949 (R. 124) there is no evidence of record that these fingers have been used after May, 1950 or the date of notice, namely, June 6, 1952.

The testimony of the appellant's witness Kauth clearly established that the appellee could not have been using such fingers after May 19, 1950 (R. 123). Mr. Kauth testified that the fingers sold in 1949 were different from those which were sold in 1950 and that they could not be interchanged (R. 120:8-19). Further, there is no testimony offered by appellant than when Thys and counsel visited the Oeste ranch that they at any time observed the appellee using the picking finger of the type sold in 1949. Rather, the testimony as pointed out above is all to the effect that Mr. Thys

immediately recognized the fingers on the Oeste machine as being sold by his licensee Moxee City Warehouse and the same finger type that Mr. Thys, himself, purchased from Moxee City Warehouse and uses (R. 94:23-27).

The testimony of the appellant's witness Westlake confirms that such early purchased fingers were not being used after May, 1950, or after the giving of notice of infringement by the filing of this action on June 6, 1952.

This testimony is as follows: The appellee only uses the alleged infringing type of picking finger on her small arm picker and small jump drums, but does not use such fingers on the large main drums of her equipment where the majority of the picking fingers are placed (R. 203:14). Mr. Westlake testified that the appellee's machine has 10 little drums on the arm picker (R. 203:18-20) and that each of the arm picker drums carries 20 picker bars (R. 204); and he further testified that the 4 small jump drums on the appellee's machine likewise are equipped with the alleged infringing finger and that these small jump drums carry 12 bars (R. 203-204).

In July, 1949 (R. 124), the appellee purchased sufficient picking fingers to replace all the finger bars on 2 of the small jump drums, or 24 bars; there being 12 bars to a drum.

In May, 1950, the appellee replaced these picking finger bars by purchasing 24 bars of the new type as testified to by the appellant's witness Kauth (R. 120:8-19; 123:31).

Also, on May 11, 1951, the appellee purchased sufficient finger bars to replace all of the bars on the 10 small drums of the arm picker, which said drums carry 20 bars to the drum, or 200 bars for the 10 drums, and purchased as well an additional 25 bars for the 2 remaining small jump drums, carrying 12 bars to the drum or 24 bars in all.

In other words, analytically, the evidence is :

1. Equipment using alleged infringing finger :
 - (a) 4 small arm picker drums having 12 finger bars each, or..... 48 bars
 - (b) 10 jump drums, having 20 finger bars each or..200 bars

 Total number of bars machine equipped with.....248 bars

2. Alleged infringing fingers purchased :
 - (a) July 15, 1949, 24 bars or a sufficient number to equip only 2 small arm picker drums, having 12 finger bars each (R. 124).....Replaced
May 19, 1950
 - (b) May 11, 1951, 225 bars purchased, or a sufficient number to replace the finger bars on the 10 jump drums or 200 bars and 2 arm picker drums of 24 bars (R. 124).....225 bars
 - (c) May 19, 1950, 24 bars purchased, or enough to replace the previously purchased 24 bars in July, 1949 (R. 123 :31).....24 bars

 Total bars purchased and used after May, 1950.....249 bars

Since it is well established that damages are not recoverable without due notice of the patent having been given, and the record herein is barren of any evidence that such due notice was given prior to June 6, 1952, the date of the filing of the action, and the record further establishing there was no alleged infringement by the appellee after May 19, 1950, there was patently no probable cause for the bringing of the action. And the record establishes such was well known to the appellant.

VI

That the appellant was well aware that there was no probable cause for the instigating of this action is shown by the testimony of the appellant's president, Mr. Thys, who contradicted himself in such a manner as to amount to outright perjury.

Mr. Thys, as noted above, stated unequivocally and clearly that on September 5, 1951, when he first saw the alleged infringing finger of the appellee he recognized its source instantly (R. 51-52). This, of course, he could not have denied in view of his accusations against the Moxee City Warehouse people in 1950 that he considered this finger to be an infringement of the Letters Patent in suit (R. 49; 131), and, also, by reason of the fact that Mr. Thys purchases the fingers he uses from Moxee City Warehouse (R. 94:23-25). Mr. Thys also testified that in June and July of 1951 (prior to seeing the appellee's alleged infringing finger), he contacted the Dauenhauer Manufacturing Company at Santa Rosa (R. 50-51), and was, therefore, well acquainted with the type of finger being manufactured by the Dauenhauer Manufacturing Company. (This finger of the Dauenhauer Manufacturing Company can be observed at but a glance to be a wider and heavier finger than that manufactured for the Moxee City Warehouse people by the California Spring Company at Los Angeles (R. 49-50) (Pl. Exh. 12).

[And, it is significant to note, that the appellant made no effort to take the deposition of Mr. Florian Dauenhauer, d/b/a Dauenhauer Manufacturing Company, but left this chore to the appellee (R. 109:23-26). However, at the time of the trial, the appellant on its case in chief (showing the importance of this evidence to the Court), endeavored to give the impression that the appellant had taken this deposition and that the appellant was only too eager to place before the trial court all of the evidence. The appellant went so far as to take the exhibits from the appellee's deposition and introduce them as its own under such designation as "Plaintiff's Exhibit 12, the Dauenhauer Manufacturing finger." (R. 111:29-32)

Anyone can tell by merely a glance at the exhibit referred to (Pl. Exh. 12) and the alleged infringing finger (Pl. Exh. 11-11A) that they are not of the same manufacture. Therefore, the witness Thys (a man who is in his middle 50's and employed in the hop growing-picking industry for the last 20 years), as well as his patent counsel, were not in the least misled as to the source of the appellee's picking finger.]

Yet this witness Thys told the trial court he was under the impression that the appellee's finger was of the Dauenhauer manufacture! (R. 55:6-11).

That the witness Thys believed it necessary to go to such great lengths in an effort to hoodwink the trial court clearly establishes the guilty conscience of the witness.

Further, it is significant to note that in charging Mr. Florian Dauenhauer with infringement of this finger, Mr. Dauenhauer did not acquiesce in the charge of infringement, but only stopped manufacturing the finger because (as he advised the appellant's counsel herein) (R.261) to fight the infringement suit was too costly. Here we have evidence of the most cogent nature that it would be grossly inequitable for the appellee to be left to bear the burden of her heavy counsel fees in all three of these unjustified litigation cases.

cf: *Frank Adam Electric Co. v. Colts etc.*, 148 F.2d 497.

If there had been the least bit of *truth* in what Mr. Thys testified to, the question arises why did he not join the Dauenhauer Manufacturing Company in the suit?

If there had been the least bit of *good faith* on the part of the appellant in instigating this suit the appellant would not have continued its prosecution in the manner in which

it did after the appellant's attention was particularly directed to the license agreement in appellee's answer (R. 8:(14)); would not have continued to prosecute the case after the appellant was compelled at the trial to disavow all old elements in the alleged "mechanical devices" relative to the anchoring means (Op. Br. 9; R. 211-212; 101:10-13) and would not have prosecuted the case further after the appellant was unable to establish any alleged infringement on the part of the appellee after May 19, 1950, or after the date of due notice by filing the action, June 6, 1952 (R. 131), or to continue after the time the rejected Claim 27 was directed to Mr. Thys' attention (R. 74).

Under the circumstances of this case, therefore, including this frivolous appeal on the part of the appellant it would be manifestly unjust and grossly inequitable that the defendant-appellee should be left to bear the heavy burden of her own counsel fees; if any litigant ever was entitled to the benefit of the provisions of Section 285, Title 35 of the United States Code this appellee is.

VII

It would appear that it must have been through some oversight that the trial court erred in not awarding the defendant - appellee reasonable attorneys' fees as prayed for in her answer. It is believed that it would be utterly impossible to find a factual situation of more grossly inequitable and unconscionable conduct on the part of a litigant than is established herein on the part of the appellant. Consequently, the appellee herein can only rationalize the failure of the Court to make such an award as one of oversight. This is especially true, when it is to be noted that the Opinion of the District Court makes no mention of the reason for its failure to have made such an award as prayed for by the appellee.

And, it is submitted, that this Court should take into consideration the inability of the appellant in this case or the appellants (Thys Company and Horst Company) in the co-pending appeal No. 13,885, to state any coherent specification of error in either of these appeals. In fact, reviewing the records as a whole, there seems to be considerable indication that the only purpose of these appeals was in reality to permit the appellants to continue to collect royalty payments during the pendency of these appeals, namely, the years 1953, 1954 and 1955. It appears to the appellee's counsel such royalty payments will amount to approximately \$145,665.00 for this three-year period.

This figure is arrived at by taking the baleage of the appellant's licensees shown in Plaintiff's Exhibit 18 for Identification, in the co-pending appeal, (No. 13,885; R.448-449), together with the Plaintiff's Exhibit 15 in the same appeal (No. 13,885; R. 413-417) establishing a rate of \$5 per bale (as it is believed that the appellant was not any more onerous upon the appellee herein in charging her \$5.00 per bale than the appellant was to the other growers). Therefore, it must be assumed, there being no evidence to the contrary, that each of the other growers were also obligated to pay \$5.00 a bale per year. This means approximately \$48,550.00 for each of the three years involved, 1953, 1954 and 1955. Of course, this only covers the Sacramento Valley growers and does not include any growers who might be affected by the litigation herein who reside in Oregon or Washington; there being a considerable number of growers in each of these two states.

It should also be noted from the referred to chart (Pls. Exh. 18, for Ind., Appeal No. 13,885; R. 448-449) that the individual grower is not taxed a sufficient amount in royalty payments to make it financially sound to incur the heavy

expense of invalidating the patents at issue in these two appeals. Further, it must be taken into consideration that the license agreement of the appellant is of the omnibus type, as shown in the agreement between the appellee herein and the appellants in the co-pending appeal No. 13,885 (Pls. Exh. 15, Appeal No. 13,885; R. 413, 417) and it is conceivable that one of the patents included might be valid, as well as useful, which the appellant would, no doubt, deprive the grower the use of if such grower should challenge the validity of any of the other patents included in the license. However, the license tax of \$5 per bale is based upon all of the patents being valid. (Cf: Br. of Appellee, Appeal No. 13,885, p. 67).

Further, this surmise of the real reason for these appeals is also borne out by the very dilatory manner in which the appellant herein prepared its record for printing on appeal; taking from July 1953, to January, 1954, and then, only after the appellee had forced the completion of the record by a motion to dismiss.

CONCLUSION

It is submitted that there was an abuse of discretion on the part of the District Court in failing to award reasonable attorneys' fees to the appellee as provided for in Section 285, Title 35, U.S.C., in view of the overwhelming record of many acts of inequitable, unconscionable, unfair and oppressive tactics indulged in by the appellant herein against the appellee, as well as the clear-cut evidence in the record of bad faith on the part of the appellant in instigating this infringement action and continuing to prosecute the same against the appellee; that such failure on the part of the District Court must be said to have resulted from an erroneous conception of law on the part of the trial judge.

Shingle Product Patents, Inc. v. Gleason, 9 Cir., 1954,
211 F.2d 437.

Further, it is submitted that on the authority of such cases as *Blanc v. Spartan Tool Co.*, 178 F.2d 104 and *E. V. Prentice Co. v. Associated Plywood Mills*, D.C. Ore, 1953, 113 F. Supp. 182, 188 that the appellee is entitled to an award of reasonable attorneys' fees of the actual amount expended in the defense of the action in the trial court or in no event less than \$7,500.00.

Further, it is submitted that pursuant to such cases as *Blanc v. Spartan Tool Co.*, *supra*, the appellee is entitled to have an award made by this Court of reasonable attorneys' fees in the actual amount expended for such services on this appeal and in no event less than \$2,500.00;

Further, it is submitted that this Court should take into consideration the oppressive burden that has been placed upon the appellee by reason of the appellant's violation (in this appeal and Appeal No. 13,885, co-pending) of this Court's rules as well as Rule 75(d) of the Federal Rules of Civil Procedure, thereby necessitating additional expense for legal fees by requiring appellee's counsel constantly to check and recheck the record from every conceivable angle in order to ascertain, if possible, what the appellant's point on appeal could possibly be, as well as to see whether the meagre record is sufficient for appellee's purposes. This last burden is required as the courts have held that the appellee may not recover costs for printing of needless portions of the record.

Further, it is submitted, that it is necessary that appellee's counsel undertake to discharge this referred to burden, for while this Court has held it is not required to consider points not properly presented, it may at its discretion do so.

Consequently, the appellee if she wishes to protect her judgment below, must endeavor to uncover any conceivable merit this Court may on its own motion determine exists in these two abortive briefs of the appellant. That the appellee's counsel was unable to find any such merit, does not mitigate against the necessity for undertaking the burden.

Therefore, it is submitted the appellee is entitled to an award of reasonable attorneys' fees in both this appeal and in the co-pending Appeal No. 13,885, in an amount of not less than \$2,500.00 for each appeal.

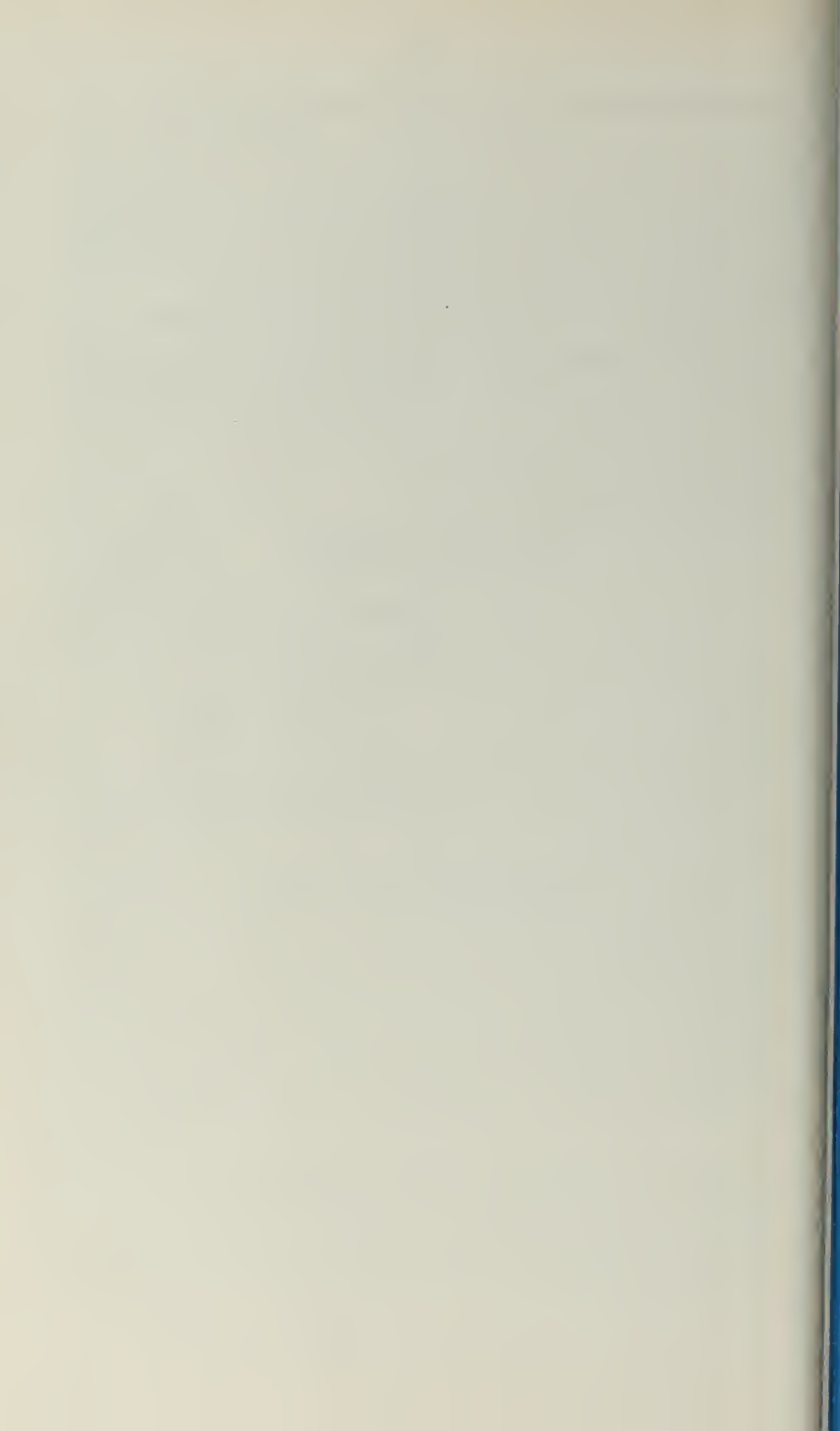
Dated: September 10, 1954.

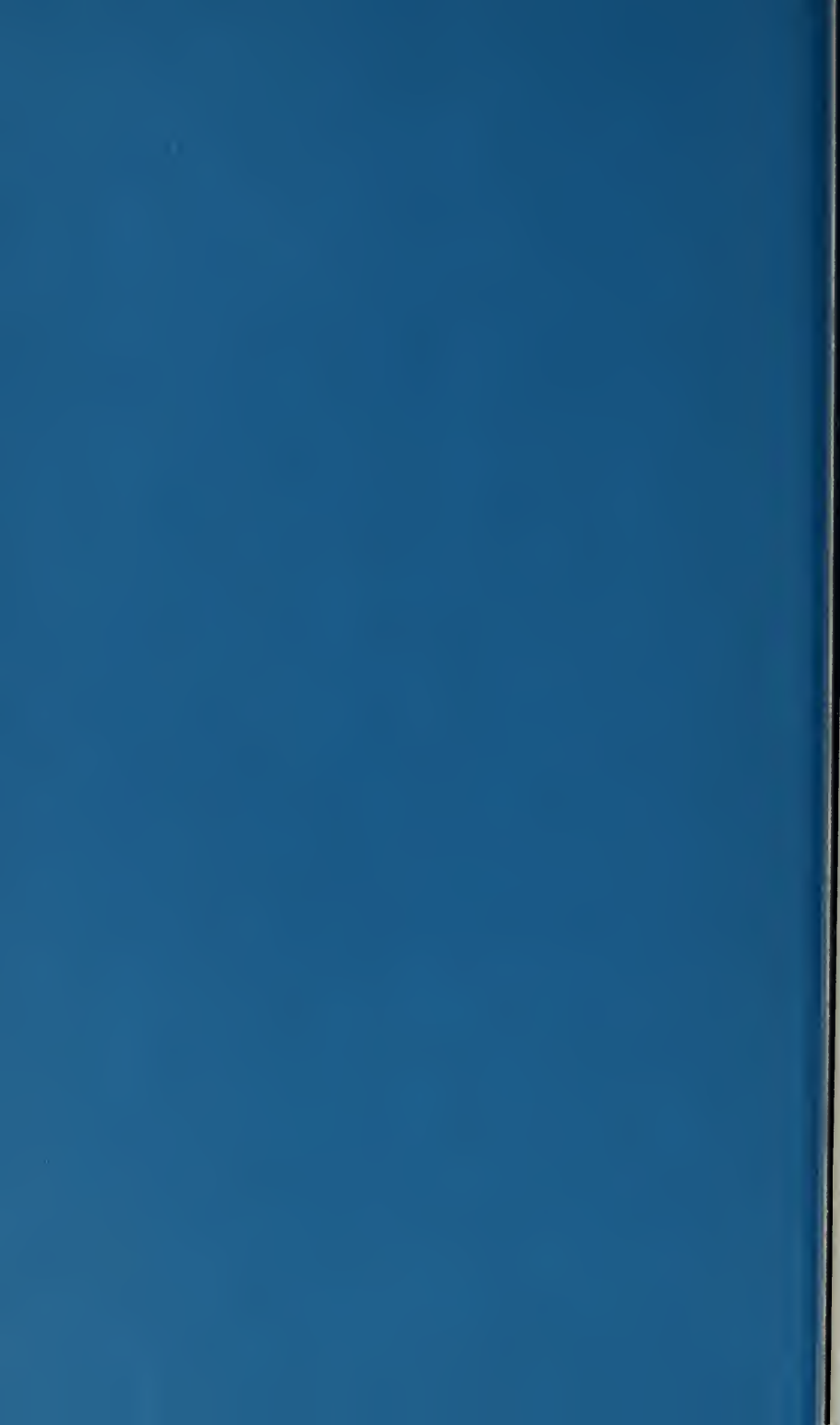
Respectfully submitted,

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(APPENDIX FOLLOWS)





APPENDIX I

TOWNSEND, TOWNSEND & HOPPE
901-905 Crocker Building
620 Market Street
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Attorneys for Plaintiff

*In the United States District Court
Northern District of California
Northern Division*

Thys Company, a corporation

Plaintiff,

vs.

Sophie Oeste, an individual,

Defendant.

Civil Action
No. 6669

PLAINTIFF'S AMENDMENTS AND ADDITIONS
TO FINDINGS OF FACT
AND CONCLUSIONS OF LAW
PROPOSED BY DEFENDANT

Now comes the plaintiff and, pursuant to Rule 5(e) of the Rules of Practice of this Court, submits the following suggestions and criticisms with respect to the Findings of Fact and Conclusions of Law proposed by defendant.

Proposed Finding 5.

Finding 5 proposed by plaintiff (sic) should be eliminated. It does not appear to be material to the Opinion of the Court.

the Court being of the opinion that the testimony of Mr. Trabucco on this point was an incidental matter (Opinion, Page 8).

Proposed Finding 8.

Lines 3 and 4 of this proposed finding (Page 5, Lines 1 and 2) should be changed to read: "had two legs of a picking finger twisted together to give it rigidity." Defendant is in error in contending that plaintiff conceded that the Trowbridge Patent had a disclosure of two adjacent legs of adjacent picking fingers twisted around each other to give rigidity to the fingers. In this connection the plaintiff calls the attention of the Court to the reporter's transcript of arguments, Pages 7, and 59-60, and to the Opinion of the Court, Page 7.

Proposed Findings 13 and 14.

Proposed Findings 13 and 14 should be eliminated. Defendant suggests these two findings to support a claim for attorneys' fees. There is no evidence in this record warranting the charge that the plaintiff acted without proper cause or reasonable provocation and in the absence of good faith. There is no suggestion in the Opinion of the Court that the Court was of the view now tendered by defendant.

Proposed Conclusion of Law 3.

In proposed Conclusion of Law 3, Page 7, Line 23, the language "together with reasonable attorneys' fees" should be stricken. As pointed out in connection with the discussion of proposed Findings of Fact 13 and 14, this matter is not covered in the Court's Opinion and there is no evidence from which it may be inferred that this is an exceptional case within the provisions of U.S.C. Title 35, Section 285.

Conclusion.

The plaintiff, in making the foregoing suggestions and criticisms, is guided solely by the Opinion of the Court and makes the suggestions as a matter of form so that any Findings and Conclusions which may be entered will be within the bounds of the Court's Opinion and in conformity therewith. By making the foregoing suggestions, plaintiff does not admit that any of the proposed findings are supported by the record or that they are not clearly erroneous.

Respectfully submitted,

/s/ STEPHEN S. TOWNSEND
Stephen S. Townsend

/s/ CHARLES E. TOWNSEND, JR.
Charles E. Townsend, Jr.

/s/ CARL HOPPE
Carl Hoppe
Attorneys for Plaintiff

Receipt of three copies of the foregoing is hereby acknowledged this 24th day of March, 1953.

*One of the Attorneys for
Defendant*

J. C.
O.

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